TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1952

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No. 46

HUGH W. SANFORD, PETITIONER,

vs.

ROBERT C. KEPNER

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

PETITION FOR CERTIORARI FILED MAY 2, 1952

CERTIORARI GRANTED JUNE 9, 1952

SUPREME COURT OF THE UNITED STATES

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., AUG. 11, 1952.

[fol. 1]

IN THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF PENNSYLVANIA

HUGH W. SANFORD, Plaintiff-Appellant,

vs

ROBERT C. KEPNER, Defendant

[fol. 2] AMENDED COMPLAINT

Amended Complaint To Authorize Issuance Of Patent And For Declaratory Judgment

(1) Plaintiff, Hugh W. Sanford, is a citizen of the United States and a resident of Knoxville, in the County of Knox, in the State of Tennessee.

(2) Defendant, Robert C. Kepner, upon information and belief, is a resident of Bloomsburg, in the County of Columbia, in the State of Pennsylvania.

(3) This complaint is filed under the Patent Laws of the United States, Section 4915 of the Revised Statutes, as amended, (U. S. Code, Title 35, Section 63), and under the Declaratory Judgments Act (U. S. Code, Title 28, Sections 2201 and 2202), and under U. S. Code, Title 28, Section 41.

(4) On January 3, 1945, the said Hugh W. Sanford, being the original, first and sole inventor of improvements in Latch Tripping Mechanism, duly filed in the United States Patent Office an application for Letters Patent of the United States on said invention, Serial No. 571,170, which application complied in all respects with the requirements of the law in such cases made and provided, and with the Rules of Practice of the United States Patent Office.

(5) On August 4, 1943, the defendant, Robert C. Kepner, alleging to be the inventor of certain improvements in Dump Car Control, filed an application for Letters Patent of the United States, Serial No. 497,286, the legal title to which application has been and was vested in the defendant, according to the records of the United States Patent Office, on March 17, 1949.

(6) On October 22, 1946, the Commissioner of Patents declared an interference, No. 82,623, between the aforesaid

application of Hugh W. Sanford, Serial No. 571,170, and the aforesaid application of Robert C. Kepner, Serial No. 497,286, the issue of which interference comprised the following counts:

Count 1. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of [fol. 3] tripping mechanism including means for actuating the latch to release the door, and separate means laterally spaced from said release means and substantially in the same upright transverse plane as said release means and actuated by bearing engagement with the under portion of the vehicle moving over the tripping mechanism for controlling the release means.

Count 2. In conveying mechanism, the combination with a trackway, a dumping conveyance mounted on the trackway and including a lading body with a drop bottom door and latch means for holding the door in closed position and movable to release the door for opening, said latch means being located wholly above the lowest portion of the lading body in the same longitudinal vertical plane of the conveyance, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement relative to the trackway in position for engaging the latch means during movement of the conveyance over the tripping mechanism to release said door, yieldable means normally tending to hold said engaging member in an elevated position, and a contact member substantially fixed relative to the releasing member and movable therewith in position to be raised and lowered by engagement with the under surface of the conveyance during movement thereover.

(7) Thereafter, on June 27, 1947, the aforesaid interference, No. 82,623, was re-declared to add the following additional counts thereto:

Count 3. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along

the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including latch release means in position to engage the latch means during movement of the conveyance over the tripping mechanism to release the door for opening, [fol. 4] and means fixed relative to the latch release means and located at substantially the same elevation as said latch release means when said latch release means is in latch engaging position, and said means being in position for engagement by the under surface of the conveyance during movement thereof over the tripping mechanism for controlling the releasing position of the latch release means.

Count 4. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement to a position for engagement by the latch means during movement of the conveyance over the tripping mechanism, a contact member fixed relative to said engaging member and extending to substantially the same elevation to be guided along the under surface of the conveyance to depress the engaging member beneath the conveyance, and yielding means normally tending to hold said engaging member in a raised position relative to the trackway.

(8) Testimony was taken on behalf of both parties in said interference, No. 82,623, and the plaintiff, Hugh W. Sanford, duly furnished proof establishing his priority in said interference and complied in all respects with the provisions of the law and the Rules of Practice of the United States Patent Office governing interference proceedings.

(9) Upon the final hearing of said interference, No. 82,623, the Board of Interference Examiners awarded priority of invention of the subject matter in issue therein to the said Robert C. Kepner, the defendant.

(10) No appeal has been taken by the plaintiff in said interference to the United States Court of Customs and Patent Appeals to review the decision of the Board of Interference Examiners therein.

[fol. 5] (11) Consequently, the Commissioner of Patents has refused, and still refuses, to grant Letters Patent of the United States to the plaintiff upon the aforesaid application of the said Hugh W. Sanford for the inventions embraced in the claims heretofore set forth as the counts of said interference, although the said Hugh W. Sanford is lawfully entitled thereto.

(12) The defendant, Robert C. Kepner, has heretofore and still is claiming in the aforesaid interference, No. 82,623 and in his application, Serial No. 497,286, as aforesaid, that he is entitled to a patent for the subject matter of the claims involved in said interference, as aforesaid, notwithstanding that said claims are unpatentable to the defendant in his said application for the following reasons:

(a) That said claims do not read on the disclosure in the aforesaid Kepner application, Serial No. 497,286.

(b) That the said claims are unpatentable to the defendant in view of the following prior patents and prior inventions:

No. 423,500	Townsend	Mar. 18, 1890
No. 430,546	Sharp	June 17, 1890
No. 530,939	Fox	Dec. 18, 1894
No. 601,203	Truax	Mar. 22, 1898
No. 628,876	Wall	July 11, 1899
No. 775,778	Neilson	Nov. 22, 1904
No. 894,204	Hogan	July 28, 1908
No. 936,443	Gibson	Oct. 12, 1909
No. 995,316	Baubert	June 13, 1911
No. 1,146,081	Labit	July 13, 1915
No. 1,195,975	Carmichael	Aug. 29, 1916
No. 1,370,472	Miller	Mar. 1, 1921
No. 1,378,574	Weston	May 17, 1921
No. 1,388,388	Swank	Aug. 23, 1921
No. 1,753,163	Spelling	Apr. 1, 1930
No. 1,876,637	Dietrichson	Sept. 13, 1932
No. 2,225,462	Rose	Dec. 17, 1940
No. 2,225,463	Rose	Dec. 17, 1940

[fol. 6] No.	2,399,708	Sanford	May 7, 1946
German No.	61,803	Meyer	Sept. 2, 1891
French 1st Addition to No.	19,989 / 469,275	Renauld	Oct. 5, 1915
Austria No.	112,784	Nussbaum	Nov. 15, 1928

and possibly others not now known to the plaintiff, and notice of which will be given the defendants as soon as learned by the plaintiff, and of which proof will be offered at the trial.

(c) That the said claims are unpatentable to the defendant, because of public knowledge and use by the Pruden Coal and Coke Company, Pruden, Tennessee, of a device embodying the subject matter of the aforesaid claims prior to the date of invention alleged by the defendant, Robert C. Kepner, and more than a year prior to the date of his application, Serial No. 497,286, filed August 4, 1943.

(d) That the said claims are unpatentable to the defendant because the subject matter thereof was on sale and sold by the Sanford-Day Iron Works, Inc., Knoxville, Tennessee, more than a year prior to the amendment of said Kepner application to include the subject matter of said claims.

Wherefore, the defendant, Robert C. Kepner, is not entitled to the grant of a patent for said claims in his application, according to Section 4886 of the Revised Statutes (U. S. Code, Title 35, Section 31).

Wherefore, the plaintiff, having no other adequate relief save by this Honorable Court, respectfully prays:

1. That this Court adjudge that the plaintiff, Hugh W. Sanford, is entitled, according to law, to receive Letters Patent of the United States for the aforesaid invention and as specified in the claims herein set forth as the counts of the aforesaid interference, No. 82,623, and as contained in his application, Serial No. 571,170.

[fol. 7] 2. That the Court adjudge that the plaintiff, Hugh W. Sanford, was the first, true and original inventor of the said improvements in Latch Tripping Mechanism, as set forth in his application, Serial No. 571,170 and defined in

the counts of interference No. 82,623, and is entitled to receive Letters Patent of the United States for the aforesaid invention and the subject matter of the aforesaid claims.

3. That the defendant, Robert C. Kepner, is not entitled to receive Letters Patent of the United States for the subject matter of the aforesaid claims, and that the claims are unpatentable to said Kepner.

4. That the plaintiff be awarded the costs of this proceeding, and for such relief as in equity may seem just.

IN UNITED STATES DISTRICT COURT

OPINION—July 9, 1951

This action is the outgrowth of an interference proceeding in the Patent Office, No. 82,623, declared by the Commissioner of Patents between the party Sanford and the party Kepner to determine which of them was the prior inventor of certain patentable subject matter common to their respective applications for patent, namely, Kepner Application Serial No. 497,286, filed August 4, 1943, and Sanford Application Serial No. 571,170, filed January 3, 1945. Consequently, upon the decision of the Board of Interference Examiners of the Patent Office in Interference No. 82,623, awarding priority of invention of the subject matter in issue to Kepner, Patent No. 2,487,447 was granted to him as provided in R.S. 4904, 35 U.S.C. § 52.

The complaint was filed under Section 4915 of the Revised Statutes, 35 U.S.C. § 63, and seeks a review of the action of the Patent Office in Interference No. 82,623, as aforesaid, and the issues raised are priority and patentability.

At the outset of the trial the Court indicated that it would hear the complete case, both as to priority and patentability, and if it became necessary in the determination of priority, the Court would consider the prior art so far as necessary for that purpose; that in the event the primary issue of priority would be determined adversely to the plaintiff, no consideration would then be given to the validity of the [fol. 8] defendant's patent, since a 4915 action is not intended to test the validity of a patent. In other words

the Court took its position with the line of cases that holds that in a 4915 action patentability need not be considered where the claimed priority is not established, and, by the same token, when the one seeking the decree under 35 U.S.C. § 63 prevails in the trial court upon the question of priority, the patentability of his claim must be decided.[1] With that concept in mind, after a full and complete trial, and on consideration of the evidence, oral arguments and briefs of counsel, I find it unnecessary herein to consider the question of patentability. The basic required formula to be followed in the attempted solution of a controversy such as we have here is that propounded in Morgan v. Daniels, 153 U. S. 120, at 125, as follows:

> "Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. * * *"

The parties to this action and to the above mentioned interference proceeding in the Patent Office are the same and the issue herein, to wit, priority of invention of the subject matter involved in the said interference, is likewise the same as there decided.

Plaintiff as the junior party had the burden of proof in the Patent Office proceeding; as the complainant here he has the burden of meeting the requirements of the Morgan v. Daniels, supra, formula. Walker on Patents (Deller's Edition) Vol. 2, Pages 971-972, states:

> "The burden is on the complainant to prove the truth of his bill, by evidence that is clear and conclusive * * *. [fol. 9] Such an action has the characteristics of a proceeding to set aside a judgment and as such, is not to be sustained by a mere preponderance of evidence. * * *"

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[1] Cleveland Trust Co. v. Berry et al., (6 Cir.) 99 F. 2d 517; Heston et al. v. Kuhlke et al., (6 Cir.) 179 F. 2d 222.

The general subject matter of the patent applications disclosing the invention in controversy is a device for unlocking the door supporting-latch of a mine car of the drop bottom type to allow the door to open for the discharge of lading. Specifically, the device consists of a tripping mechanism which is positioned in the trackway and is provided with a latch releasing member or element which is constantly pressed upwardly by a spring to an elevated position above the trackway so as to project into the path of the door latch as the car moves over the track for dumping and thus release the door latch by coming in contact therewith as the car passes along the track.

The claims, directed to the invention common to the interfering applications, are stated in the four counts of Interference No. 82,623, Sanford v. Kepner, and are as follows:

"Count 1 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism including means for actuating the latch to release the door, and separate means laterally spaced from said release means and substantially in the same upright transverse plane as said release means and actuated by bearing engagement with the under portion of the vehicle moving over the tripping mechanism for controlling the release means.

"Count 2 In conveying mechanism, the combination with a trackway, a dumping conveyance mounted on the trackway and including a lading body with a drop bottom door and latch means for holding the door in closed position and movable to release the door for opening, said latch means being located wholly above the lowest portion of the lading body in the same longi- [fol. 10] tudinal vertical plane of the conveyance, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement relative to the trackway in position for engaging the latch means during movement of the conveyance over the tripping mechanism to release said

door, yieldable means normally tending to hold said engaging member in an elevated position, and a contact member substantially fixed relative to the releasing member and movable therewith in position to be raised and lowered by engagement with the under surface of the conveyance during movement thereover.

"Count 3 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including latch release means in position to engage the latch means during movement of the conveyance over the tripping mechanism to release the door for opening, and means fixed relative to the latch release means and located at substantially the same elevation as said latch release means when said latch release means is in latch engaging position, and said means being in position for engagement by the under surface of the conveyance during movement thereof over the tripping mechanism for controlling the releasing position of the latch release means.

"Count 4 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including an engageing (sic) member mounted for upward movement to a position for engagement by the latch means during movement of the conveyance over the tripping mechanism, a contact member fixed relative to said engaging member and extending to substantially the same elevation to be guided along the [fol. 11] under surface of the conveyance to depress the engaging member beneath the conveyance, and yielding means normally tending to hold said engaging member in a raised position relative to the trackway."

Plaintiff contends that the counts of the interference involve the track, the conveyance, the latch at the back and the tripping device, all as one combination; and that the patent involves the entire structure of the protected latch car. Defendant, on the other hand, takes the position that the issue here is solely, "who was the prior inventor of the invention for latch tripping mechanism disclosed in the Sanford application No. 571,170 and the Kepner application No. 497,286 for releasing the latch of the protected latch car."

Plaintiff argues, "The defendant must show that he was the first to invent every element in the claim or the complete combination of elements before he is entitled to an award of priority." If this contention is sound, no valid claim for an improvement applicable to an old apparatus or device could ever be granted. As a matter of fact, the Sanford Application Serial No. 571,170, herein involved, states that the invention there disclosed is "for the improvement in Latch Tripping Mechanism set forth in the annexed specification;" furtherfore, in the specifications, at Page 1, it specifically states that "This invention relates to improvements in Latch Tripping Mechanism, particularly for mine cars and other conveyors having drop-bottom doors for discharge of the lading therefrom."

The drafting of the claims here involved followed the customary pattern employed when the new invention is an improvement of a particular part or portion of an old device; the claims reciting the features of the new invention and, in combination therewith, such features of the old apparatus or device as are necessary to point out the relation of the improvement to the parts of the old apparatus with which the improvement co-operates; it is in this manner that the functional purposes of the alleged improvement are made manifest. This matter was fully covered by the Supreme Court in Williams Manufacturing Co. v. United [fol. 12] Shoe Machinery Corp., 316 U. S. 364, at Page 369, as follows:

> "* * * In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with

which they were to dovetail, but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines. It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed, and equally difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines."

Plaintiff further contends that the testimony of Dendler, and of the defendant Kepner himself, justified the inference that Dendler and not Kepner invented certain features so far as they are incorporated in the dump car unlatching mechanism which is here in controversy. This contention is completely inappropriate, for as stated in Luellen v. Claussen et al., 43 App. D. C. 444,

"The question for determination in the present case is which of the parties thereto is entitled to the award of priority, and the question whether a third party may subsequently defeat the successful party here is beside the issue and may not be raised."

[fol. 13] Also, as the Court of Customs and Patent Appeals in Cooper v. Hubbell, 53 F. 2d 1072, at Page 1076, stated:

"* * * Appellant would not be entitled to an award of priority as against appellee even if the proof established that the invention was in fact made by other persons. Foster v. Antisdel, 14 App. D. C. 552. The issue

in an interference proceeding is not whether a senior party may be entitled to priority as against all persons, but the question is whether the junior applicant has sustained the burden of establishing his own priority over that of his opponent. Beidler v. Caps & Leininger, 36 F. (2d) 122, 17 C.C.P.A. 703."

The issue here is a very narrow one, namely, the priority between the junior party, Sanford, and the senior party, Kepner, of the invention of a certain latch tripping mechanism for releasing the latch of a protected latch car. We are not concerned with any other portion of the structure to which this functional device becomes a part, nor are we concerned with the prior inventive activities of any third party alien to these proceedings. What testimony then has plaintiff offered in his effort to overrule the otherwise controlling Patent Office decision as to priority of invention, and did the proffered testimony in character and amount carry thorough conviction? To attain this objective the plaintiff endeavors to overturn the finding of the Board of Interference Examiners that the latch tripping mechanism allegedly installed and tested at the rock bin of the Pruden Coal Company mine in 1942 was "nothing more than an abandoned experiment", and that "commercial use or success of the device is not necessary in order to constitute a reduction to practice but it must appear that the inventor himself is satisfied as to the practicability of the device for its intended purpose. It is quite obvious from a reading of the record that Sanford did not consider his device as practical at the time of the test at Pruden."

I am not only in complete accord with this conclusion but find it confirmed in Sanford's oath to his application No. [fol. 14] 571,700, (sic) filed January 3, 1945, in which apparently to meet the statutory requirement of a lawfully filed application for patent, he swore that he did not believe that the invention described and claimed therein was "in public use or on sale in the United States for more than one year prior to this application."

The opinion of the Board of Interference Examiners stated, inter alia:

"The device which was removed from the Pruden Coal Company has become lost and could not be found

on diligent search, however, a device was constructed during the taking of testimony allegedly like that used at the Pruden Company and introduced in evidence as Sanford Exhibit 29. Tests were run on the reconstructed device to show its mode of operation. Obviously these tests cannot be relied upon as a *nunc pro tunc* reduction to practice."[2]

Concerning the Pruden test in 1942, the plaintiff submitted, for the consideration of the Court, depositions of Robert E. Jones and the party Sanford; and the testimony of Roy E. Linville, Howard A. Page, D. E. Griffith, and Edward R. Hughes.

The evidence of Jones and Sanford is definitely opinion evidence, and both in their depositions of January 7, 1948, which are a part of the record of the Patent Office proceeding, admitted that they had never seen the device installed at Pruden in operation. Sanford's deposition of April 4, 1950, again admits that he had not seen the device in use at Pruden after its installation there in 1942, nor indeed had he seen the reinstallation at Pruden in 1948.

The testimony of Roy E. Linville, both in the Patent Office proceeding and in the instant proceeding, is completely lacking in any suggestion that he ever saw the device [fol. 15] in operation at Pruden as allegedly installed for testing in 1942.

The new testimony of Howard A. Page concerning the construction and operation of the alleged device at Pruden in 1942 is not convincing. While he stated that he helped to install the device at Pruden in 1942, he had nothing to

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[2] This same device, which was built in 1948, was reinstalled in 1950. Considerable testimony was introduced tending to show its inefficiency and also a substantial variance in the materials used in its construction from that of the 1942 device of which it was supposed to be a duplicate. I have not felt it necessary to consider either the inefficiency of the reinstallation or the variance of materials used, neither of which received consideration in the opinion of the Board of Interference Examiners and are not essential elements to the conclusions reached by the Board.

do with its operation. His testimony was given from memory and was to a degree hearsay.

D. E. Griffith appeared to be the only witness produced by Sanford who saw the device in operation at Pruden in 1942, and his testimony adds nothing of a substantial nature to his testimony given in the Patent Office proceeding.

The remaining witness was the expert, Edward R. Hughes, who admitted that he had never seen the device alleged to have been installed at Pruden in 1942. His testimony is, therefore, a completely theoretical opinion, and obviously is a direct attack on the patentability of the Kepner patent. A great portion of his testimony was devoted to a consideration of the prior art and its relation to the applications for patent here involved. None of this testimony could be considered as having any relevancy to the question of priority, which, as we have previously indicated, is our first and primary concern. This witness also testified at considerable length as to the readability and interpretation of the claims in suit. Evaluating this portion of the testimony in a light most favorable to the plaintiff, it certainly did not in my opinion qualify as being sufficiently impressive to overcome the decision of the Patent Office.

In Solomon v. Renstrom (8 Cir.) 150 F. 2d 805, the court, citing Morgan v. Daniels, supra, stated (Page 808):

> "* * * The interpretation of the claims of a patent is not to be determined by the opinion of experts, but is a question of law for the court. * * * The additional evidence was therefore simply advisory. The court was not required to accept it even though it may have stood without contradiction. * * *"

[fol. 16] and on Page 809:

> "In the final analysis, this case presents a situation in which the only testimony introduced at the trial that had not been introduced and considered by the Court of Customs and Patent Appeals was in the nature of opinions of expert witnesses. As already observed, the trial court was not bound to credit this character of testimony, and it affirmatively appears that the court

rejected it. It can not therefore be said that a conclusion contrary to that adopted by the Court of Customs and Patent Appeals was established 'by testimony which in character and amount carries thorough conviction.' "

See also Smith et al. v. Carter Carburetor Corporation (3 Cir.) 130 F. 2d 555. As the court stated in the Smith case, "where all of the tribunals which pass upon a question of priority in an interference proceeding in the Patent Office reach the same conclusion with respect thereto, a court will not overrule that conclusion unless error therein appears very clearly."

The plaintiff has completely failed to sustain his burden of establishing "by testimony which in character and amount carries thorough conviction", that the decision of the Board of Interference Examiners is incorrect.

This Opinion contains a statement of the essential facts and of the law applicable thereto in conformity with Rule 52 of the Federal Rules of Civil Procedure, 28 U.S.C. The complaint must be dismissed.

July 9, 1951.

(S) Frederick V. Follmer, United States District Judge.

[fol. 17] IN UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

No. 10,562

HUGH W. SANFORD, Appellant,

v.

ROBERT C. KEPNER

Appeal from the United States District Court for the Middle District of Pennsylvania

Argued January 11, 1952

Before Goodrich and Hastie, Circuit Judges and Burns, District Judge

OPINION OF THE COURT—Filed March 24, 1952

By HASTIE, Circuit Judge:

This litigation began in Patent Office interference proceedings where Sanford and Kepner were the opposing applicants. At that stage the Board of Interference Examiners awarded priority of invention to Kepner who thereupon received a patent covering the counts of interference. Sanford then brought a bill in equity in the district court pursuant to Section 4915 of the Revised Statutes (1875), *as amended*, 35 U. S. C. § 63 (1946 ed.), which provides:

[fol. 18] "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . . and the court, having cognizance thereof . . . may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such a patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law . . ."

In the district court, the suit was dismissed on the ground that Sanford had failed to sustain the burden imposed by *Morgan v. Daniels*, 1894, 153 U. S. 120, 125, of establishing "by testimony which in character and amount carries thorough conviction" that the decision of the Board of Interference Examiners was incorrect. This appeal contests that finding, and also, the refusal of the district judge to pass upon the issue of patentability of the alleged invention. These points will be taken up separately.

I

The general subject matter of the interfering patent applications is a device for tripping the door supporting latches on mine cars of the drop bottom type to permit discharge of the contents of the car. Kepner's application, for "Dump car Control", was filed on August 4, 1943; Sanford's for "Latch Tripping Mechanism", not until January 3, 1945. In the interference proceedings, therefore, it was incumbent on Sanford, as the junior party, to prove his priority of invention by a preponderance of evidence. This he sought to do by establishing an actual reduction to practice at the rock bin of the Pruden Coal & Coke Company in [fol. 19] Tennessee the year before Kepner by filing application with the Patent Office, had obtained a constructive reduction to practice. The testimonial evidence before the Board of Interference Examiners, however, though subject to conflicting inferences, affords adequate basis for its conclusion that the mechanism tested out at the Pruden Company proved impracticable for its intended purpose, was discarded by the Company in favor of a similar device of demonstrated utility, and was abandoned by its inventor in favor of different lines of development, until after the Kepner application had been filed.

In the district court, Sanford was confronted with a more rigorous burden of proof: *Morgan v. Daniels, supra; S. & S. Corrugated Paper Machinery Co. v. George W. Swift, Inc.*, 3 Cir. 1949, 176 F. 2d 358, 360. This he sought to surmount by additional testimony from six witnesses, four of whom had previously testified at the interference proceedings. Their credibility, insofar as affected by demeanor, was, of course, peculiarly within the province of the trier of fact.

But beyond this, only one of the witnesses, the president of the coal company, had anything to do with the operation of the Pruden device and his testimony at the trial added nothing to what he already had said at the interference proceedings. The remaining testimony, moreover, was opinion in part, hearsay in part, and, in part, equivocal. The district court was not persuaded by this additional testimony. We think it did not substantially change the overall picture presented at the interference proceedings. And with reference to that picture, in the language of the *Morgan* case, "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant". 153 U. S. at 129. In these circumstances the conclusion reached by the district court should and will be sustained.

[fol. 20] Issue is also taken with the holding of the district court that the dispute over priority related to the invention of "a certain latch tripping mechanism for releasing the latch of a protected latch car." Sanford asserts that the invention covered by the counts is "a combination *of* a trackway, a dumping conveyance, a door, a latch *and* tripping mechanism" (italics added); and that he is admittedly the prior inventor of the combination so defined. But the short answer to this contention is that the language of the counts does not lend itself to this construction. Count one is illustrative of all: "*In* conveying mechanism [general class of apparatus], the combination *with* a trackway, a dumping conveyance . . . [etc.; details of old structure], *of* tripping mechanism including . . . [details of improvement]" (italics added). Such reference in a patent claim to the structural setting within which a particular invention has been designed to operate is proper and familiar, but does not enlarge the invention. See *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 1942, 316 U. S. 364, 380.

II

Appellant further contends that the patent issued to Kepner upon termination of the interference proceeding is void for lack of invention because disclosed by prior art. As warranting adjudication of this issue he invokes both

the Declaratory Judgment Act, 28 U. S. C. § 2201 (1946 ed.) and Section 4915 of the Revised Statutes. But some manifest threat to the interests or interference with the activities of the petitioner beyond the issuance of a patent to another is required to create a controversy justiciable under the Declaratory Judgment Act between him whom the patent may injure and the patentee. *Treemond Co. v. Schering Corp.*, 3 Cir. 1941, 122 F. 2d 702, 705; followed in *Federal Telephone & Radio Corp. v. Associated Telephone & Telegraph Co.*, 3 Cir. 1948, 169 F. 2d 1012, *cert. den.*, 335 U. S. 859; Borchard, Declaratory Judgments, 1941 ed., 807. Here there is no claim that Kepner has done any-
[fol. 21] thing menacing to Sanford beyond the acquisition of letters patent. Hence, the Declaratory Judgment Act supplies no basis for relief beyond what Section 4915 may provide. The substantial question is whether, in a Section 4915 proceeding, a court, having decided that a claimant does not have priority of invention, should also pass upon the issue of patentability.

That question is not raised here for the first time. This court has held that where priority of invention is decided against the plaintiff in a proceeding under Section 4915, the patentability of defendant's invention should not be adjudicated. *Smith* v. *Carter Carburetor Corp.*, 1942, 130 F. 2d 555; *S. & S. Corrugated Paper Machinery Co., Inc. v. George W. Swift, Jr., Inc., supra*, (by implication). Such a judgment, merely dismissing the claim of priority, does not "impute any validity to the defendant's patent or approval of the claims thereof as drafted". 130 F. 2d at 560. Were it not for a persisting split of authority in the circuits and a certain measure of ambiguity engendered by what has recently been said by the Supreme Court in *Hoover Co.* v. *Coe*, 1945, 325 U. S. 79, at 89-90, we would be content to have the matter rest upon our earlier decision.

While no other circuit has held that in these circumstances the issue of patentability should not be decided, the Court of Appeals for the Sixth Circuit has held such decision unnecessary, when the issue is raised, as here, by the plaintiff who has failed to establish priority of invention; *Heston v. Kuhlke*, 1950, 179 F. 2d 222; *Cleveland Trust Co. v. Berry*, 1938, 99 F. 2d 517; *cf., Christie v. Seybold*, 1893, 55 F. 69. And, in special circumstances, the Court of Ap-

peals for the Eighth Circuit has found such decision uncalled for even in connection with an award of priority to the plaintiff. *Ericson v. Jorgensen*, 1950, 180 F. 2d 180, *cert. den.*, 340 U. S. 813.

In the Seventh and District of Columbia Circuits, on the other hand, the Courts of Appeals have declared unequivocally that patentability of the invention disclosed is the first [fol. 22] issue that should be decided by the court in a Section 4915 suit between parties to a prior interference proceeding. *Minneapolis Honeywell Reg. Co. v. Milwaukee Gas Sp. Co.*, E. D. Wis. 1948, 78 F. Supp. 569, *aff'd.* 7 Cir. 1949, 174 F. 2d 203; *Knutson v. Gallsworthy*, D. C. Cir., 1947, 164 F. 2d 497. Both courts cite as controlling authority the case of *Hill v. Wooster*, 1890, 132 U. S. 693, the significant language from which therefore bears quotation:

> "The provision of section 4915 is that the Circuit Court may adjudge that the applicant 'is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear; and that, if the adjudication is in favor of the right of the applicant, it shall authorize the Commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention . . . A determination of that issue [priority of invention] alone, in favor of the applicant, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved". *Id.*, at 698.

Priority of invention in that suit, however, in contradistinction to this, had been determined in favor of the applicant-plaintiff. And the necessity of passing upon patentability was there predicated upon the scheme of Section 4915 which has made an adjudication of priority in favor of the applicant a sufficient basis for issuance of a patent to him. But nothing in Section 4915 or *Hill v. Wooster* can be taken as requiring a district court to incorporate in a judgment dismissing applicant's claim of priority of inven-

tion an adjudication as to the defendant's entitlement to letters patent.

[fol. 23] Appellant further relies, as did the court in *Knutson v. Gallsworthy, supra,* on what was said in text and supporting footnote by the Supreme Court in *Hoover Co. v. Coe,* 1945, 325 U. S. 79, by way of distinguishing and explaining its earlier opinion in *Hill v. Wooster:*

> " . . . [T]his court held [in *Hill v. Wooster*] that if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed.[29]

We think the foregoing language suggests at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority of invention.

The judgment will be affirmed.

A true Copy:
Teste:

—— —— Clerk of the United States Court of Appeals for the Third Circuit.

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[29] "Section 16 of the Act of 1836 . . . expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention, or other cause, the question of interference disappeared." 325 U. S. at 89-90.

[fol. 24] IN UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

No. 10,562

HUGH W. SANFORD, Appellant,

vs.

ROBERT C. KEPNER

On Appeal from the United States District Court for the Middle District of Pennsylvania

Present: Goodrich and Hastie, Circuit Judges, and Burns, District Judge

JUDGMENT—March 24, 1952

This cause came on to be heard on the record from the United States District Court for the Middle District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court in this case be, and the same is hereby affirmed, with costs.

Attest:

Ida O. Creskoff, Clerk.

(File endorsement omitted.)

[fol. 25] SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1951

No. 746

HUGH W. SANFORD, Petitioner,

vs.

ROBERT C. KEPNER

ORDER ALLOWING CERTIORARI—Filed June 9, 1952

The petition herein for a writ of certiorari to the United States Court of Appeals for the Third Circuit is granted. The case is transferred to the summary docket.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

[fol. 26] IN THE SUPREME COURT OF THE UNITED STATES

STIPULATION AS TO CONTENTS OF RECORD—Filed July 30, 1952

It is hereby stipulated and agreed by and between Counsel for the Petitioner and Respondent, subject to the approval of the Court, that the following items constitute all of the essential parts of the record necessary for consideration by the Court of the question involved in the appeal:

1. The Amended Complaint.
2. The Decision of the District Court.
3. The Appeal to the Court of Appeals.
4. The Decision of the Court of Appeals.

J. Preston Swecker, Attorney for Petitioner. Wilmer Mechlin, Attorney for Respondent.

(File endorsement omitted.)

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MAY 2 1952
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CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. 746

LIBRARY
SUPREME COURT, U.S.

HUGH W. SANFORD, *Petitioner*

v.

ROBERT C. KEPNER, *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT, AND BRIEF

J. PRESTON SWECKER,
641 Washington Building
Washington 5, D. C.
Attorney for Petitioner.

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IN THE

Supreme Court of the United States

HUGH W. SANFORD, *Petitioner,*

v.

ROBERT C. KEPNER, *Respondent.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Hugh W. Sanford, respectfully prays for a writ of certiorari to the United States Court of Appeals for the Third Circuit to review a Judgment of that Court.

A transcript of the record below, including the proceedings in the Court of Appeals, so far as applicable to the question herein presented, is furnished herewith in accordance with the rules of this Court.

Summary and Short Statement of the Matter Involved

This action was instituted by the Petitioner in the United States District Court for the Middle District of Pennsylvania to obtain a judgment authorizing the Commissioner of Patents to issue a patent to the Petitioner on an invention, of which the Board of Interference Examiners in the Patent Office had awarded priority of invention to the Respondent, denying the Petitioner's right to a patent thereto.

In his complaint, Petitioner alleged jurisdiction under R. S. Sec. 4915 (35 U. S. Code, Sec. 63).

The complaint not only raised the issue of priority of invention for decision by the Court, but also the issue of patentability of the subject matter defined in the claims which were involved in the Interference proceeding in the Patent Office and averred that the patent claims were unpatentable over certain prior patents issued to Petitioner and others, as set forth in the complaint.

The District Court held that Petitioner had failed to sustain the heavy burden imposed by rule of this Court in *Morgan v. Daniels*, 153 U. S. 120, 125, of establishing "that the decision of the Board of Interference Examiners is incorrect." (S. R. 17).[1]

The Court entered a further finding that the issue of patentability need not be considered:

> "In other words, the Court took its position with the line of cases that holds that in a 4915 action patentability need not be considered where the claimed priority is not established." (S. R. 9)

On appeal, this judgment was affirmed on March 24, 1952, by the Court of Appeals for the Third Circuit. (K. R. 122).

The Court of Appeals for the Sixth Circuit has previously held that the issue of patentability should not be decided unless and until the plaintiff has established priority of invention. *Heston v. Kuhlke*, 179 F. 2d 222; *Cleveland Trust Co. v. Berry*, 99 F. 2d 517. No other Circuit has previously followed this rule of the Sixth Circuit, which was adopted in this case by the Third Circuit.

The Court of Appeals for the Seventh Circuit has declared unequivocally that the patentability of the invention disclosed is the first issue that should be decided by the Court in a suit under Section 4915 R. S. and should be decided without regard to the question of priority. *Minneapolis Honeywell Reg. Co. v. Milwaukee Gas Specialty Co.*, 174 F. 2d 203.

The Court of Appeals for the District of Columbia has also held unequivocally that the issue of patentability

[1] K. R., as used herein, refers to Kepner Record; S. R. refers to Sanford Record.

should be decided without regard to priority in a suit under Section 4915 R. S. *Knutson v. Gallsworthy*, 164 F. 2d 497.

The Court of Appeals for the Third Circuit in the above-entitled cause followed the rule of the Sixth Circuit rather than that of the Seventh Circuit and the District of Columbia, although noting but refusing to follow the latter. Thus the Third and Sixth Circuits have decided one way on this issue and the Seventh Circuit and the District of Columbia have decided directly contrary on the same issue and under the same circumstances.

This Court has not previously decided this precise issue, but is asked to resolve the conflict between the different circuits on the same question.

Question Presented

Should the District Court have decided the issue of patentability, in a suit under Sec. 4915, R. S., of the counts of the Interference, first and foremost, even though the issue of priority be decided in this suit, against the plaintiff?

Jurisdiction

The Statutory provision believed to sustain the jurisdiction of this Court is Title 28 U. S. Code, Section 1254.

Jurisdiction is also indicated by Rule 38, 5 (b) of this Court, as follows:

> "(b) Where a circuit court of appeals has rendered a decision in conflict with the decision of another circuit court of appeals on the same matter."

The date of the judgment which Petitioner seeks to have reviewed is March 24, 1952. The Mandate of the Court of Appeals has been stayed to May 8, 1952, and thereafter until decision of this Court on condition that the Petition and Record have been filed herein before that date.

Cases in which this court has granted certiorari to resolve conflict of opinion as between different circuits on the same question are:

Stelos Co. v. Hosiery Motor-Mend Corp., 295 U. S. 237, 238.

Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U. S. 471, 472.

General Electric Co. v. Jewel Incandescent Lamp Co., 326 U. S. 242, 243.

Reasons Relied Upon for Allowance of the Writ

The Courts of Appeal in several different Circuits have decided directly contrary on the same issue of patentability raised in an interference suit under Section 4915 R. S., which conflict of opinion should be resolved.

This court held in *Hill v. Wooster*, 132 U. S. 693, that the court should determine the issue of patentability before authorizing the issuance of a patent, but that case is distinguished by the Court of Appeals by the determination therein of the issue of priority in favor of the plaintiff.

The language of this court in *Hoover Co. v. Coe*, 325 U. S. 79, referred to in Footnote 29 (p. 90 of 325 U. S.) makes clear that the Court was of the view that the issue of patentability should be decided first and foremost, but because the case referred to the earlier opinion in *Hill v. Wooster*, the Court of Appeals for the Third Circuit has refused to follow the plain import of the language of this Court therein.

This Court has many times indicated that the question of patentability is of public importance, and when the issue of patentability or validity is raised in a case, it should be decided by the court in the public interest, as noted for instance in *Sinclair & Carroll Co. Inc., v. Interchemical Corp.*, 325 U. S. 327, 330:

> "It has come to be recognized, however, that of the two questions, validity has the greater public importance."

Wherefore your Petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court, directed to the United States Court of Appeals

for the Third Circuit, commanding such Court to certify and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this action, to the end that this action may be reviewed and determined by this Court; that the judgment of the Court of Appeals be reversed; and that Petitioner be granted such other and further relief as may seem proper.

J. Preston Swecker,
Attorney for Petitioner

Washington, D. C.
April 29, 1952

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The Opinions of the Courts Below

The opinion of the District Court is in the record at S. R. 8, and is reported at 99 F. Supp. 221, 90 USPQ 188. The opinion of the Court of Appeals for the Third Circuit is in the record at K. R. 122, and is reported at 194 F. (2d) ----, 93 USPQ 57.

Argument

The issue of patentability of the invention disclosed by the respective parties to an interference proceeding is the first issue that should be decided by the court in a suit under Section 4915 R. S.

The Court of Appeals for the Sixth Circuit has ruled unequivocally that it is unnecessary to decide the issue of patentability when raised unless the plaintiff has established priority of invention. *Heston v. Kuhlke*, 179 F. 2d 222; *Cleveland Trust Co. v. Berry*, 99 F. 2d 517.

The finding of the Court of Appeals for the Third Circuit was said to be based on a decision of this court in *Hill v. Wooster*, 132 U. S. 693, 698, in which this Court stated:

"It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved. * * * But neither the Circuit Court nor this court can overlook the question of patentability."

This Court did not state in *Hill v. Wooster* which issue should first be determined, but it did assert definitely that the issue of patentability should be decided in a suit under Section 4915 R. S. Such an adjudication of the issue of patentability was not made determinable only in the event that the plaintiff had first established priority of invention, but the Court held that it was a proper issue to be raised and not overlooked.

This Court has not decided this issue since *Hill* v. *Wooster*, and no case is found in this Court involving the issue of patentability without an adjudication of priority for the plaintiff. However, the issue was referred to by inference from the language of the court in *Hoover Co. v. Coe*, 325 U. S. 79. The opinion by Justice Roberts repeated the language from *Hill v. Wooster*, again without the qualification imposed upon it by the decisions in the Sixth Circuit, and stated that "if it appear that neither application disclosed invention," the bill should be dismissed. In a footnote to that portion of the opinion is the following:

"[20] Section 16 of the Act of 1836, 5 State. 123, *supra*, expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was

void for lack of invention or other cause, the question of interference disappeared." (p. 90 of 325 U. S.)

The Court of Appeals for the Third Circuit disregarded the language of the Footnote by Justice Roberts, with the assertion that the

> "language suggests at most a privilege. certainly not a duty, of the District Court to pass upon patentability at the instance of an unsuccessful claimant of priority of invention."

It is submitted that the Court of Appeals has failed to give due consideration to the language of Justice Roberts in Footnote 29, and to the earlier decision of this court in *Hill v. Wooster*, where the court has made quite clear, it is submitted, that the District Court should pass upon patentability at the instance of a plaintiff without regard to the issue of priority, first and foremost.

The statute referred to in the Footnote provides specifically that the court may adjudicate either patent to be void without regard to the issue of priority. This language in the Footnote can hardly be interpreted any other way than to imply the same meaning to Section 4915 R. S., even though the same language was not used therein. The court should decide the issue of patentability first and foremost, without regard to the issue of priority, as suggested by Justice Roberts.

This is the interpretation placed upon that language by the Court of Appeals for the District of Columbia in *Knutson v. Gallsworthy*, 164 F. 2d 497; 74 USPQ 324, in a carefully prepared opinion by Justice Prettyman.

The opinion in *Knutson v. Gallsworthy* was based on appeals from decisions by the District Court denying to the plaintiff priority of invention as to all counts there involved, even that which had previously been decided in his favor by the Patent Office. The complainants were dismissed by the District Court on priority alone. This action was reversed by the Court of Appeals upon a careful and extensive review of the authorities on this question, including the decisions of this Court in *Hill v. Wooster* and *Hoover Co. v. Coe*. The Court of Appeals stated:

"* * * We go only so far as to say that patentability is a proper issue in a proceeding under Section 4915 and, if raised, must be decided, even though the Patent Office decision from the case arose was in an interference proceeding." (p. 501 of 164 F. 2d).

The Circuit Court of Appeals for the Seventh Circuit has taken precisely the same view of the statute and decision of this Court in *Hill v. Wooster* as the Court of Appeals for the District of Columbia, as announced in *Triplett et al v. Line Material Co.*, 133 F. 2d 533, 56 USPQ 398. There, without deciding the issue of priority in favor of the plaintiff, the District Court dismissed the complaint for lack of invention, which was affirmed by the Court of Appeals:

"* * * Defendant contends, and the District Court held, that it was the province of the court, under Hill v. Wooster, 132 U. S. 693, * * * to determine first of all whether the applications disclose patentable inventions. This, we think, is correct. * * * (p. 534 of 133 F. 2d).

* * * * *

"In view of the facts mentioned and further evidence in the record which we do not deem it essential to refer to, the District Court properly held the claims embraced in the two applications not patentable. In view of our conclusions, it is unnecessary to discuss the issue of priority or that of invalidating sales.

"The judgment is affirmed." (p. 536 of 133 F. 2d).

The Court of Appeals for the Third Circuit in this case did not attempt to distinguish those cases in the Seventh Circuit and the District of Columbia, but conceded a contrary decision, a conflict of opinion between the several circuits on this issue of deciding patentability at the instance of an unsuccessful plaintiff on the issue of priority:

"In the Seventh and District of Columbia Circuits, on the other hand, the Courts of Appeal have declared unequivocally that patentability of the invention dis-

closed is the first issue that should be decided by the court in a Section 4915 suit between parties to a prior interference proceeding."

The Court of Appeals referred thereto another decision in the Seventh Circuit in *Minneapolis Honeywell Regulator Co. v. Milwaukee Gas Specialty Co.*, 174 F. 2d 203, where the language of the court is to the same effect as noted above in *Triplett v. Line Material Co.*

In both of these cases in the Seventh Circuit, Justice Minton, then on the Court of Appeals for the Seventh Circuit, joined in the decisions.

This conflict of opinion between the several circuits on the same issue is a matter of great importance and should be resolved by this Court. It is submitted that the Court of Appeals has failed to give due consideration to the applicable language of the decisions of this Court, and that the correct rule is that applied by the Seventh Circuit and the District of Columbia, that the issue of patentability, when raised, must be decided first and foremost without reference to the issue of priority.

For the foregoing reasons, it is submitted that this Court should be moved to grant the *writ of certiorari* to the end that the fundamental question of patent law here involved may be settled by this Court, resolving the conflict of opinion as between different circuits on the same question, and that the judgment of the Court of Appeals for the Third Circuit be reversed.

Respectfully submitted,

J. PRESTON SWECKER,
Attorney for Petitioner.

Washington, D. C.
April 29, 1952

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MAY 29 1952
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. 46.

HUGH W. SANFORD, *Petitioner,*

v.

ROBERT C. KEPNER, *Respondent.*

PETITIONER'S REPLY TO BRIEF OF RESPONDENT.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 746.

HUGH W. SANFORD, *Petitioner*,

v.

ROBERT C. KEPNER, *Respondent*.

PETITIONER'S REPLY TO BRIEF OF RESPONDENT.

The Petitioner Has Not Conceded That He Is Not the First Inventor of the Subject Matter of This Controversy.

The Brief of Respondent asserts erroneously that "the Plaintiff had conceded he was not the first inventor" (p. 7), and therefore urges the Court to deny review for lack of a "case or controversy". On the contrary, the Petitioner has urged, both in the District Court and in the Court of Appeals, his priority of invention of the subject matter of the controversy. The Petitioner has never conceded, and does not now concede, that he was not the first inventor of the subject matter here involved.

Petitioner did not urge in his Petition for a Writ of Certiorari that the Court of Appeals erred in deciding the question of priority because it was presumed that this Court would not review the case on priority since that involved a question of evidence which this Court does not

ordinarily review. The question of priority involved an issue of fact as to which there was no diversity of opinion since only the Court of Appeals for the Third Circuit has decided that issue.

The Petitioner Sought Review by This Court of the Question of Law, whether the District Court should have considered the issue of patentability first and foremost even though the issue of priority be decided against the plaintiff. If the District Court committed error in ruling that the issue of patentability should not be decided, this was an error of law that should be corrected without regard to the issue of priority. Certainly there was a "case or controversy" before the Court under Section 4915 R.S., when the error was committed by the District Court.

This Court frequently has granted a Writ of Certiorari to review an interlocutory question of law, in a case under Section 4915 R.S., without deciding the issue of priority, as in *Hoover Co.* v. *Coe*, 325 U. S. 79, where the question presented and decided by this Court was as follows:

> "The question presented is whether a District Court has jurisdiction of a suit under R.S. 4915 to review the refusal of a claim for patent as not reading on the application. The court below answered in the negative."

The argument of Respondent goes solely to the merit of the appeal rather than the question of diversity of opinion between different circuits.

In neither *Triplett* v. *Line Material Co.* (C.C.A. 7), 133 F. 2d 533, nor *Knutson et al.* v. *Gallsworthy* (C.A.D.C.), 164 F. 2d 497, was the issue of priority involved in the Appeal. Both cases turned solely on the interlocutory question of law, the same question presented here for decision, as a result of the contrary opinion of the Court of Appeals for the Third Circuit. In the *Triplett* case neither the Court of Appeals for the Seventh Circuit nor the District Court even passed on the issue of priority. The case in

both Courts involved solely the issue of patentability. The propriety of that decision, contrary from the decision on the same issue in this case in the Court of Appeals for the Third Circuit, is the point sought to be reviewed on this appeal.

It is clear that from a careful consideration of this case that an issue of law is presented which this Court should review on the question presented by the Petition.

Therefore Petitioner stands upon his Petition and all of the reasons therein relied upon for the allowance of the writ.

Respectfully submitted,

J. Preston Swecker,
641 Washington Building,
Washington 5, D. C.,
Attorney for Petitioner.

Washington, D. C.
May 29, 1952.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, PETITIONER

vs.

ROBERT C. KEPNER

BRIEF FOR PETITIONER

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Supreme Court of the United States

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, PETITIONER

vs.

ROBERT C. KEPNER

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, PETITIONER

vs.

ROBERT C. KEPNER

BRIEF FOR PETITIONER

The petition was filed herein for review of a decision of the United States Court of Appeals for the Third Circuit.

The Opinions of the Courts Below

The opinion of the District Court appears at R.6, and is reported in 99 F. Supp. 221, 90 USPQ 188. The opinion of the Court of Appeals for the Third Circuit appears at R.16 and is reported in 195 F.2d 387, 93 USPQ 57.

Jurisdiction

The Statutory provision believed to sustain the jurisdiction of this Court is Title 28, US. Code, Section 1254.

Jurisdiction is also indicated by Rule 38, 5 (b) of this Court, there being a conflict of opinion between several Circuit Courts of Appeal on the question involved herein.

The order allowing certiorari was granted June 9, 1952, (R.23).

Concise Statement of the Case

This action was instituted by the Petitioner in the United States District Court for the Middle District of Pennsylvania to obtain a judgment authorizing the Commissioner of Patents to issue a patent to the Petitioner.

In his amended complaint (R.1), Petitioner alleged

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† Appendix, p. 19.

jurisprudence under Sec. 4915 R.S. (35 U.S. Code, Sec. 63).[1]

The Petitioner has filed an application for Letters Patent for an invention for which the Respondent also had made an application for Letters Patent. While these two applications were pending, an interference proceeding was instituted by the Patent Office to determine the issue of priority of invention between the parties. As a result thereof, priority was awarded to the Respondent, Robert C. Kepner.

The Petitioner's application then was rejected by the Commissioner of Patents, by order of the Board of Interference Examiners, because of the alleged priority of invention of the Respondent. The Petitioner filed his complaint in the District Court for review of the finding of priority, and also to determine the issue of patentability of the subject matter defined in the counts of said interference proceeding (R.2-3). The amended complaint (R.1) set forth that the Respondent was not entitled to an award of priority because the counts were unpatentable to the Respondent in view of certain prior patents issued to the Petitioner and to others, as set forth in the amended complaint (R. 4-5).

The District Court held that Petitioner had failed to sustain the heavy burden imposed by rule of this Court in *Morgan v. Daniels*, 153 U.S. 120, 125, of establishing "that the decision of the Board of Interference Examiners is incorrect." (R. 15). Therefore, the Court found for the Respondent on the issue of priority.

The District Court entered a further finding that the issue of patentability need not be considered

> "In other words, the Court took its position with the line of cases that holds that in a 4915 action patentability need not be considered where he claimed priority is not established." (R.7).

On appeal, this judgment was affirmed by the Court of Appeals for the Third Circuit. (R. 18-21).

Thereafter this petition was filed for the consideration of the following question:

Should the District Court have decided the issue of patentability, in a suit under Sec. 4915, R.S., of the counts

[1] Appendix, p. 16

of the interference, first and foremost, even though the issue of priority be decided in this suit, against the plaintiff?

Assignment of Errors

It is submitted that the Court of Appeals erred:

1. In refusing to hold that the District Court should consider, first and foremost, the issue of invention of the counts of an interference proceeding, in a bill in equity under Section 4915, R.S.

2. In holding that Section 4915, R.S., does not require a District Court to incorporate in a judgment dismissing an applicant's claim of priority of invention an adjudication of the patentability of that invention.

3. In holding that a District Court, in a bill in equity filed under Section 4915, R.S., involving the question of priority of invention, should not pass upon the issue of patentability of the patent claims which were the subject matter of the interference proceeding in the Patent Office.

Summary of Argument

The decision of the Court of Appeals below is contrary to the language of the Statute, Section 4915, R.S., as revealed by the clear import of its terms, and from its legislative background.

The Statute clearly states that where an applicant for a patent is dissatisfied with the decision of the appropriate Board in the Patent Office, he may have remedy by a bill in equity, and the Court may adjudge that the applicant is entitled to receive a patent "as the facts in the case may appear." This rewording of the language in Section 16 of the Patent Act of 1836[2] "as the fact of priority of right or invention shall in any such case be made to appear" is intended to have the same meaning and certainly not a more restricted meaning, limited only to priority and not patentability, as the Court below has held.

The decision of the Court of Appeals below misapplies the decisions of this Court in *Hill v. Wooster*, 132 U.S. 693, 698, and in *Hoover Co. v. Coe*, 325 U.S. 79, in which this Court has plainly stated that the question of patenta-

[2] Appendix, p. 20.

bility of the involved counts of the interference should be determined by the District Court in a suit under Section 4915, R.S.

Other Courts of Appeal have followed the decisions of this Court consistently, as in *Triplett et al v. Line Material Co.*, 133 F.2d 533, 56 USPQ 398; *Minneapolis Honeywell Regulator Co. v. Milwaukee Gas Specialty Co.*, (C.A. 7), 174 F.2d 203; and *Knutson v. Gallsworthy* (Dist. of Col.), 164 F.2d 497, 74 USPQ 324.

Argument

The decision of the Court of Appeals below is contrary to the language of the Statute, Section 4915, R. S., as revealed by the clear import of its terms and from its legislative background.

This Court has reviewed the history of Section 4915, R.S., at considerable length in *Hoover Co. v. Coe*, 325 U.S. 79, 90. As therein pointed out, the origin of this Statute was contained in the Patent Act of 1836, Section 16[2], which provided that "whenever a patent on application shall have been refused on an adverse decision of a board of examiners" the applicant "may have remedy by bill in equity", and the Court may adjudge that the applicant receive a patent for his invention, "as the fact of **priority of right or invention** shall in any such case be made to appear."

Section 16 of the Act of 1836 had provided for a remedy by bill in equity both in the case of interfering patents already issued or granted and the case of interfering applications or rejection of pending applications.

The then existing patent laws were combined in the Consolidation Patent Act of July 8, 1870, wherein these provisions were separated, and Section 52 thereof[3] was made to apply to rejected applications, while Section 58 provided for suit in the case of interfering issued patents. Actions relating to interfering patents are now covered by Section 4918, R.S. (35 U.S. Code, Sec. 66), not here involved.

The Consolidation Act of 1870 was referred to by this Court in *Butterworth v. Hoe*, 112 U.S. 50, 66:

[2] Appendix, p. 17
[3] Appendix, p. 21

"The Act of July 8, 1870, 16 Stat 198, revised, consolidated and amended the statutes then in force on the subject, and the substance of its provisions, material to the present inquiry, have been carried into the existing revision."

The provisions of the Act of 1870 were incorporated in the Revised Statutes of 1873. These provisions, however, respecting a bill in equity for review of a rejection of a patent application, contain the same language in this portion thereof dealing with the adjudication of the right of the applicant, whether he is entitled to receive a patent for his invention "as the facts in the case may appear". This is a mere modification of the language, a consolidation of the terms in the earlier Patent Act of 1836, which made it quite clear in so many words that the Court of Equity should adjudge that "the fact of **priority of right or invention** shall in any such case be made to appear."

The earlier provision in the Act of 1836, therefore, spelled out in so many words that both priority and invention should be determined in the equity suit. This provision could not have been misunderstood, as there expressed.

It must be apparent from a consideration of the Statutes of 1836 and 1870 that there was no intention on the part of Congress to change the provisions with respect to the adjudication in such equity suit of priority or invention. On the contrary the language used in the Act of 1870, and which was later carried over into the Revised Statutes, shows that the change of language was merely an omission of surplusage, a consolidation, the substitution of words which were clearly intended to mean the same thing.

The earlier Statute of 1836 had specified that the issue in such bill in equity was the fact of priority or invention. The change of "'fact" to "facts" in the Statute of 1870 and the Revised Statutes, Sec. 4915, show that Congress intended both the fact of priority and the fact of invention, to be a proper issue in such suit.

This conclusion is confirmed by the first draft of the

Consolidation Patent Act of 1870, as first passed by the House of Representatives, according to Volume 95, The Congressional Globe, for June 24, 1870, page 4820. This provision of the statute, as contained in the House Bill, constituted Section 48.[4]

This Section 48 had specified that the subject matter of the equity suit should be restricted to matter in the decision of the Commissioner but that the suit should determine what is the invention. The substituted provision according to Section 52 of the Act of 1870 is obviously a change in language of original Section 48 without any evident change of intention. On the contrary it would appear that the language used in Section 52 of the Act of 1870 is the same language that appears in Section 4915, R.S., providing that the Court should adjudge that the applicant is entitled to receive a patent "as the facts in the case may appear", which imposed a duty on the Court to determine invention as well as priority with respect to the applicant's claims.

Thus we see that all through these several statutes there is an indicated intention on the part of Congress that a suit in equity to obtain a patent should determine both priority and invention. It was not to be restricted merely to the matter which appeared in the decision of the Commissioner but that full investigation of the facts and invention is evidenced by the language of the Act of 1836, and the original draft of this Bill which was merely rewritten by the Senate in the form in which it appeared in the Act of 1870.

Consequently, an applicant seeking relief under Section 4915, R.S has a right to a determination, when requested, of **priority or invention**. Either was a proper issue in the suit. The Court should determine either or both questions, if put in issue by the parties, determining whether the party is entitled according to law to his patent "as the facts in the case may appear", not only the issue of priority but also the issue of patentability.

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[4] Appendix, p. 21

This is the interpretation which this Court has applied to the language of the Statute in *Hill v. Wooster*, 132 U.S. 693, 698, and in *Hoover Co. v. Coe*, 325 U.S. 79.

The decision of the Court of Appeals below has misapplied the decisions of this Court.

The opinion of the Court of Appeals below characterized the language of this Court in *Hoover Co. v. Coe*, 325 U.S. 79, as engendering "a certain measure of ambiguity" (R.19) in the applicable decisions on this question, and misapplied entirely the language of the Court in *Hill v. Wooster* stating that nothing therein required

> "a district court to incorporate in a judgment dismissing applicant's claim of priority of invention an adjudication as to the defendant's entitlement to letters patent". (R.20-21).

In *Hill v. Wooster*, the bill in equity was filed to review a holding by the Board in the Patent Office that the plaintiff was not entitled to the grant of a patent because he had not established priority of invention over the defendant. The case was decided on priority alone. This Court noted that neither party raised the issue of patentability. Both parties were perfectly willing to have the matter decided solely on priority without any adjudication of the question of patentability. This was not sufficient, however, in the view of this Court:

> "It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the

> sanction of the court to the patentability of the invention involved. * * * But neither the Circuit Court nor this court can overlook the question of patentability." (698 of 132 U.S.)

This Court did not find it necessary even to consider the issue of priority, and thus relegated that issue to secondary importance. Contrary to the expressed view of the Court of Appeals below, this Court clearly indicated therein that the issue of patentability should have first consideration and the District Court should decide the question of invention or patentability as well as priority, when put in issue.

The Court of Appeals below interpreted this language of the Court in *Hill v. Wooster* as suggesting

> "at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority." (R. 21)

Such an interpretation of the language of this Court appears to be unjustified where the Court in *Hill v. Wooster* failed to base its decision on priority, but decided the case solely on patentability.

There would have been more reason for the interpretation of the Court of Appeals if the decision in *Hill v. Wooster* were based on priority as the first consideration, and then, if that issue be decided in favor of the plaintiff, had gone ahead and decided the issue of patentability as of secondary importance. However, this Court did not even consider the issue of priority, but clearly indicated by the manner in which the matter was decided that patentability was the first, and foremost, consideration.

This court has many times indicated that the question of patentability is of public importance, and when the issue of patentability or validity is raised in a case, it should be decided by the court in the public interest, as noted, for instance, in *Sinclair & Carroll Co. Inc., v. Interchemical Corp.*, 325 U.S. 327, 330.

"It has come to be recognized, however, that of the two questions, validity has the greater public importance."

If there were any doubt about the decision in *Hill v. Wooster*, this was clarified by the statement in the opinion of Justice Roberts in *Hoover Co. v Coe*, 325 U.S. 79, in the footnote attached thereto:

"29. Section 16 of the Act of 1836, 5 Stat. 123, *supra*, expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention or other cause, the question of interference disappeared." (p. 90 of 325 U.S.).

Justice Roberts was a judge of great learning in the field of patent law. His opinions show a profound understanding of this branch of the law. In that case he had made a thorough study not only of this particular section, but also of its relation to prior laws and to its legislative history, as revealed in the opinion itself.

Certainly such a carefully prepared opinion does not justify, it is submitted, the expressed suggestion in the decision of the Court of Appeals below that it engendered "a certain measure of ambiguity" in this question. On the contrary, if there were any previous misunderstanding, that statement by Justice Roberts should have removed all possible doubt, and left it perfectly clear that the Court should decide invention or patentability, as well as priority, when put in issue.

Justice Roberts stated therein that the change in language from Section 16 of the Patent Act of 1836 to Section 52 of the Act of 1870, and the similar provision of Section 4915, R.S., was merely an omission of surplusage, a consolidation of language without change of intent. The clear expression in the

Act of 1836 that the Court should decide the bill in equity "as the fact of **priority of right or invention** shall in such case be made to appear" was merely shortened to the words "as the facts in the case may appear". In all other respects this portion of the statute was the same.

Had the Congress intended to restrict the provision to a decision on priority alone, it would have been a simple matter to have said in the Act of 1870 "as the fact of priority of right shall in any such case be made to appear". On the contrary, the Congress did not so frame this portion of the law in consolidating the provisions in the Act of 1870. The Congress changed this language to "the facts", whatever they may be with respect to the issues raised in the suit, whether priority or invention. Such issue, properly raised in the suit, that is relevant to the determination of the right to patentability, should be decided by the District Court. Both invention and priority are germane to that question.

That is the interpretation which has been placed on this section of the statute by the Court of Appeals for the District of Columbia, having regard to the decisions of this Court both in *Hill v. Wooster* and in *Hoover Co. v. Coe*, supra.

In *Knutson v. Gallsworthy*, 164 F. 2d 497, the decision, written by Justice Prettyman, reviewed at considerable length the authorities on this question and held that the issue of patentability must be decided. There, as in this case, the District Court had confirmed the decision of the Patent Office on priority so that the plaintiffs had not prevailed on the issue, and did not prevail in the Court of Appeals. Nevertheless, the Court of Appeals did not find it necessary to decide the issue of priority, but rested its decision solely on the issue of patentability. The Court stated in part as follows:

"We have reexamined the cases cited by the Court to the foregoing, but in none of them does it appear that the trial court declined to pass upon an

issue raised in the pleadings before it. (p. 500 of 164 F. 2d).

* * * * * * *

"We note also that the (Supreme) Court referred with apparent approval to the decision of this Court in *Radtke Patents Corp. v. Coe*, in which we held that if an issue as to patentability is raised in the District Court in an action under R.S. §4915, it must be decided. In the case at bar, the issue of patentability was raised in the District Court and is raised here, and so must be decided. * * * (p. 500 of 164 F.2d).

"*We go only so far as to say that patentability is a proper issue in a proceeding under Section 4915 and, if raised, must be decided, even though the Patent Office decision from which the case arose was in an interference proceeding.*" (p. 501 of 164 F. 2d. Italics ours.)

The Court of Appeals below conceded a diversity of opinion on this issue not only with respect to the District of Columbia Court of Appeals, but also with respect to the Court of Appeals in the Seventh Circuit, according to the decisions in *Triplett v. Line Material Co.* (C.C.A. 7), 133 F. 2d 533, 56 USPQ 398, and *Minneapolis Honeywell Regulator Co. v. Milwaukee Gas Specialty Co.* (C.A. 7), 174 F. 2d 203.

In the Triplett case the opinion of Judge Lindley, joined in by Justice Minton when sitting on that court, stated:

"Defendant contends, and the District Court held, that it was the province of the court, under *Hill v. Wooster*, 132 U.S. 693, *to determine first of all whether the applications disclose patentable inventions.* This, we think, is correct. (p. 534 of 133 F. 2d.)

* * * * * * *

"In view of the facts mentioned and further evidence in the record which we do not deem it essential

to refer to, the District Court properly held the claims embraced in the two applications not patentable. *In view of our conclusions, it is unnecessary to discuss the issue of priority* or that of invalidating sales.

"The judgment is affirmed." (Italics ours). (p. 536 of 133 F. 2d.)

This was reiterated in the Minneapolis case, affirming the decision of the District Court, per curiam:

"He concluded as a matter of law that in an action to obtain a patent, the court must determine first of all whether the applications disclose patentable invention, and that the claims should be read in the light of the specifications and construed in the light of all the facts."

Refusing to follow those earlier decisions in other circuits, as well as the decisions in this Court, as mentioned above, the Court of Appeals below, as did the District Court (R. 7), referred to decisions in the Sixth Circuit (R. 19) in *Heston v. Kuhlke*, 179 F. 2d 222, and *Cleveland Trust Co. v. Berry*, 99 F. 2d 517. The earlier of those cases in the Sixth Circuit was decided before the clarifying language of this Court in *Hoover Co. v. Coe*, if it needed clarification, and the latter case merely reiterated the same holding without reexamining the issue in the light of Justice Roberts' opinion. Consequently, those decisions no longer should be followed, and both the District Court and the Court of Appeals below fell into clear, reversible error in following such authorities, rather than the decisions of this Court in *Hill v. Wooster* and *Hoover Co. v. Coe*, and the decision of the Court of Appeals for the District of Columbia in *Knutson v. Gallsworthy* which was based on that same authority.

This Court had a proper concept of the matter involved in deciding that the District Court should consider both priority and patentability in a bill in equity under Section 4915, R.S., because priority is necessarily involved

with the issue of patentability and requires a determination of the position of the invention in the art to which it appertains.

The court cannot decide priority in a vacuum.

It is essential that the Court take into consideration the art in which the invention is made, and determine the place in the art which the invention occupies in order properly to evaluate the scope or protection of the counts or the claims of the interference proceeding. The interpretation of the claims is essential to the determination of priority, and is a proper issue in a bill in equity under Section 4915, R.S. *General Electric Co. v. Steinberger*, 208 Fed. 699, 717; affirmed (C.C.A. 2), 214 Fed. 781, 786.

Doubtless the framers of the patent law had this concept clearly in mind, that it is necessary to determine the place in the art that the invention occupies in order to decide whether the applicant seeking a patent is entitled to one. The Congress provided in the Act of 1836 for a decision on a bill in equity of priority or invention, as shall be made to appear. These are the controlling facts, priority and invention. They are the facts as in the case may appear according to the Act of 1870 and the Revised Statutes, Section 4915. The latter is not restricted to the determination of the single fact of priority, but to determination of "the facts", priority and invention, as "in the case may appear".

The Respondent has sought to mislead the Courts below by urging that this is an attempt to void the patent issued to him. The petitioner has not urged that the Court has jurisdiction to pass on the validity of the patent as a whole. However, the counts of the interference may be considered both as to priority and as to invention. The fact that these counts also appear as claims in the Respondent's patent does not affect the duty of the Court to determine invention as well as the priority of the interference counts.

This was clearly stated by the Court in *Butterworth v. Hoe*, 112 U.S. 50, 63:

"Thus every case is fully provided for, both when the Commissioner wrongfully refuses to issue a patent, and when, in cases of interference, he erroneously issues one; * * * ".

The Importance of the Question Presented.

The decision below would prohibit the District Court from receiving evidence on the question of patentability of the invention involved in an interference proceeding. The Court would be left with the alternative either of refusing to decide the question of invention, or if decision be made, it is likely to be a nullity because the Court would not have all the evidence that would bear on the question of invention.

In this instance, the patentability of the interference counts may depend upon the relation of the subject matter thereof with respect to Petitioner's prior patent, as set forth in the amended complaint (R. 4-5), taken alone or with other patents listed. This relation is also important to the question of priority and should have been considered at the same time by the District Court so that the Court would have had the relation of these respective applications and patents to have determined whether the Respondent has made any patentable invention over the alleged prior invention of the Petitioner, as disclosed in his earlier patent. Therefore, the patentability of the involved counts to the Respondent is in fact material to the question of priority.

Had the Court considered the question of invention first as it should be, it is very likely that an entirely different view would have been had as to the question of priority, because the District Court then would have been able to evaluate the smallest of contributions made by the Respondent, if any, over Petitioner's prior patent, taken alone or with other patents set forth in the amended complaint.

Consequently, it is not just a matter of reviewing the prior art and determining whether the claims here

involved may be patentable over this, but it has a very real bearing on the question of priority which the District Court decided without the benefit of the relation of the present invention to Petitioner's prior patent.

Where the District Court does take into consideration the prior art and the relation of the counts of the interference to that prior art, a very different result may be obtained as to the question of priority in the interference. Consequently, the matter here urged is of great importance, because it tends to result in a more nearly correct decision on priority, as well as protecting the public interest in adjudicating the question of invention as well as priority in the one suit.

Conclusion

Both the language of the Statute and the decisions of this and other courts having proper cognizance of the question have held unequivocally that the District Court should decide both priority and patentability when raised in a bill in equity, filed under Section 4915, R.S.

Therefore, it is submitted that the decision of the Court below should be reversed, with directions to review fully the questions raised by the amended complaint.

Respectfully submitted

J. Preston Swecker,
Attorney for Petitioner

Washington, D.C.
September 29, 1952

APPENDIX

Statutes Involved

Revised Statutes of 1874, Section 4915 (35 U.S. Code, Section 63):

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally

taken and produced in the suit. R.S. Section 4915; February 9, 1893, c. 74, Section 9, 27 Stat. 436; March 2, 1927, c. 273: Section 11, 44 Stat. 1336; March 2, 1929, c. 488, Section 2(b), 45 Stat. 1476; August 5, 1939, c. 451, Section 4, 53 Stat. 1212."

[2] Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

"Section 16. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. Provided however, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment."

[3]Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof as the facts in the case may appear. And such adjudication if it be in favor of the right of the applicant shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

[4]H.R. 1714:

"Section 48. *And be it further enacted*, That whenever a patent or a reissue of a patent is refused on application therefor, after appeal to the Commissioner, for any reason whatsoever, the applicant may give notice to the Commissioner of the points and matters concerning which he deems the decision erroneous, by filing his objections in writing thereto, within thirty days from the rendering of such decision; and he may have his remedy against such erroneous decision by a suit in equity in any circuit court of the United States within whose jurisdiction the Commissioner of Patents and any of the necessary parties to such suit may be found; and all persons who may be interested in such application for a patent

may be made parties to such suit; and the Commissioner and all other persons who may be made parties defendant in such suit, may answer the same and avail themselves of all defenses which the law may allow thereto; *and the subject matter of such suit shall not extend to or include any matter not set forth in the objections to the decision of the Commissioner*, and to the determination upon the evidence of what the invention or discovery of the applicant, and for which he may be entitled to a patent, actually is." (Italics added.)

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, *Petitioner*

v.

ROBERT C. KEPNER, *Respondent*

PETITIONER'S REPLY TO BRIEF FOR RESPONDENT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD, *Petitioner*

v.

ROBERT C. KEPNER, *Respondent*

PETITIONER'S REPLY TO BRIEF FOR RESPONDENT

Morgan v. Daniels, 153 U. S. 120, Did Not Decide Issue Here Involved

Much of the argument of the Respondent stems from his contention that this Court held in *Morgan* v. *Daniels* that the issue of patentability in a suit under § 4915 R. S. need not be decided by the Court if priority is found against the plaintiff. On the contrary this Court did not pass upon that question in *Morgan* v. *Daniels*, apparently because it was not raised. Consequently, that decision is not applicable to the present question.

Morgan v. *Daniels* decided only the question of the character of testimony required to overcome a Patent Office holding on priority in a suit under R. S. § 4915. It has

often been cited for that rule, and was so relied upon both by the District Court and by the Court of Appeals below in this case. It seems particularly significant, however, that neither of those Courts relied upon *Morgan* v. *Daniels* in support of the finding by those Courts that the issue of patentability need not be decided even though such issue was raised both in the complaint and in the proofs submitted.

On the other hand, *Hill* v. *Wooster*, 132 U. S. 693, was relied upon by both the District Court and the Court of Appeals in support of the conclusion reached by those respective courts that if priority should be decided in favor of the plaintiff, then patentability of the involved claims should be decided. This Court made clear in *Hill* v. *Wooster* that patentability is a proper issue to be raised in an action under R. S. § 4915.

Where the pleadings and proofs raise that issue, the Court should decide it without deciding only one issue, priority, raised in the pleadings. This is indicated further by Rule 54(b) of the Federal Rules of Civil Procedure, which precludes a final judgment "at any time before the entry of judgment adjudicating all the claims".

The complaint filed herein put in issue two questions, one of which was patentability, and the second was priority. The District Court decided only the issue of priority without decision of patentability.

The Brief for the Respondent admits (page 8) that neither decision, *Hill* v. *Wooster* or *Morgan* v. *Daniels*, "bars a decision on patentability in any case". This is a startling admission where the remainder of the Respondent's argument seems to be that *Morgan* v. *Daniels* bars a decision on patentability in any case where priority has not been decided in favor of the plaintiff. Since *Morgan* v. *Daniels* does not bar a decision on patentability in any case, as in fact it does not, and since Petitioner has raised the issue of patentability, the District Court should have decided that issue as one of the claims for relief under Rule 54(b), F.R.C.P.

The position of Petitioner herein has been stated clearly in his brief (page 6, last paragraph), that an applicant seeking relief under R. S. § 4915 has a right to put in issue, and to have determined, both patentability and priority. This is the rule which has been applied in the Seventh Circuit and in the District of Columbia.

Consistent Decisions in Other Cases

The Brief for Respondent argues that the cases in those Circuits are not inconsistent with the cases in the Sixth Circuit relied upon by the Courts below, and attempts to show a consistency through an apparent misstatement of the facts, contrary from the interpretation thereof set forth in the Brief for Petitioner.

In *Knutson* v. *Gallsworthy* (C.A.D.C.), 164 F. 2d 497, it is asserted in the Brief for Respondent that "the Trial Court found priority for a plaintiff as to one of the counts, making the determination of patentability mandatory" (page 11). This statement appears to be erroneous because the District Court not only failed to find any issue of priority in favor of the plaintiffs in the several actions, but it even decided against the plaintiffs on one claim that had been awarded to them by the Patent Office and, therefore, took away whatever claim of priority they had been previously awarded. It is submitted that it cannot be said fairly of the decision in that *Knutson* case that patentability was decided because of a decision for the plaintiff on priority. The contrary is definitely stated in the opinion of the Court of Appeals that patentability is a proper issue in a proceeding under R. S. § 4915 "and, if raised, must be decided". That is precisely the position of the Petitioner here.

In *Minneapolis Honeywell Regulator Co.* v. *Milwaukee Gas Specialty Co.* (C.A. 7), 174 F. 2d 203, the Brief for Respondent states (page 11) that the Trial Court "adjudged the plaintiff entitled to a patent", and therefore decided patentability. On the contrary, the Court con-

sidered first and foremost the question of patentability and the prior art for the purpose of interpreting the scope of the claims. Only then was the issue of priority considered. That also is precisely the position of the Petitioner here.

It seems significant that the Court of Appeals below did not attempt to distinguish either of these *Knutson* and *Minneapolis* cases on the statement of facts, as does the Respondent here, but the Court of Appeals recognized that its decision was directly contrary therefrom. The Court of Appeals stated that those Circuits "have declared unequivocally that patentability of the invention disclosed is the first issue that should be decided" (R. 20), when put in issue by the pleadings and proofs.

The Brief for Respondent states further that footnote 29 in *Hoover Co.* v. *Coe*, 325 U. S. 79, had reference to R. S. § 4918 rather than R. S. § 4915. This is not the case because it stated specifically that it applied to a bill filed after Patent Office decision on interference. § 16 of the Act of 1836 did in fact cover both interfering applications and interfering patents. § 4918 provided specifically that either interfering patent could be declared invalid. Such a provision was omitted, as stated by Justice Roberts in footnote 29, from § 4915, as surplusage. Consequently, the footnote amply described the situation as to this provision of the statute, and confirms the view expressed in the *Knutson* and *Minneapolis* cases that patentability is a proper issue to be raised, and should be decided.

The Respondent refers to amendments of R. S. § 4915 after previous decisions of this Court. The only previous decision on this question was *Hill* v. *Wooster*, that patentability should be decided. Consequently, such construction must prevail to the extent there adjudicated.

The Respondent expresses grave fears as to the effects of a reversal of this erroneous decision by the lower Courts. His fears are entirely unfounded. There is no likelihood that the Trial Court will be called upon "to decide patentability in all cases". None of these cases goes so far.

In both of the *Knutson* and *Minneapolis* cases, it is only when the issue of patentability "if raised, must be decided". That is precisely the position of the Petitioner here.

Right to Determination of Question Presented.

The Respondent argues that because the Petitioner did not confuse the issue here involved with an argument of his rights as to priority, the second issue raised in the District Court, the Petitioner has no standing in this appeal. The fallacy of this argument should be evident.

As noted in Petitioner's Reply Brief on Petition for Certiorari, the Petitioner has never conceded, and does not now concede, that he was not the first inventor of the subject matter here involved. However, this Court has frequently reviewed interlocutory questions of law, as in *Hoover Co.* v. *Coe*, 325 U. S. 79.

The decision of the Court of Appeals on priority adjudicated only that issue against the Petitioner on the evidence there before the Court, but the judgment is not final until all issues have been determined, according to Rule 54(b) F.R.C.P. The cases cited for the Respondent on this question apply only where the Court could grant the plaintiff no relief of any kind, but the decision on priority by the Courts below neither forecloses the District Court from reconsidering the question of priority in the light of the prior art, and an interpretation of the counts thereby, nor does it decide the issue of patentability as raised in the complaint.

It will be noted that one of the prayers in the complaint (R. 6) was as follows:

> "3. That the defendant, Robert C. Kepner, is not entitled to receive Letters Patent of the United States for the subject matter of the aforesaid claims, and that the claims are unpatentable to said Kepner."

The adjudication of that issue should be had in the District Court. It is one of the issues raised and one that is to be decided. Until that has been done and judgment entered, the Court has jurisdiction and power to grant plaintiff the relief sought in that prayer.

Respectfully submitted,

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Attorney for Petitioner.

Washington, D. C.
October 23, 1952.

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No. 946

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 746

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION

Opinions Below

The opinion of the United States District Court for the Middle District of Pennsylvania, setting forth its findings of fact and conclusions of law, appears at pages 8a-17a of Sanford's Record (S. R.) and is reported in 99 F. Supp. 221, 90 U. S. P. Q. 188. The opinion of the United States Court of Appeals for the Third Circuit is reported in 93 U. S. P. Q. 57.

Jurisdiction

Petitioner's alleged basis for jurisdiction to review this proceeding is Title 28 U. S. Code, Sec. 1254, which prescribes the methods of review by this Court of cases or controversies in courts of appeals. He also relies on Supreme Court Rule 38, 5(b).

Statement

Sanford, petitioner herein, and Kepner, respondent herein, were in interference in the Patent Office with respect to certain counts. The Board of Interference Examiners of the Patent Office adjudged Kepner the prior inventor (S. R. 22) and he thereupon received a patent containing, as claims, the counts of the interference (S. R. 8).

Sanford instituted this action under R. S. 4915 (U. S. C. Title 35, Sec. 63) in the District Court wherein he sought to obtain a judgment authorizing the Commissioner of Patents to issue to him a patent for the counts involved. His complaint raised the issues of priority of invention and patentability of the counts to Kepner (S. R. 3-8). No counterclaim was filed by Kepner.

The District Court, like the Patent Office, found that Sanford was not the prior inventor (S. R. 17). On this basis it entered a judgment dismissing the complaint. The Court found it unnecessary to pass upon the patentability of the counts involved (S. R. 9).

The Court of Appeals, too, found the issue of priority against Sanford (S. R. 124) and, in affirming the judgment of the District Court, would not direct it to pass upon the patentability of the counts (S. R. 128).

In his petition for certiorari Sanford does not challenge the findings of the Patent Office, the District Court and the Court of Appeals that he was not the prior inventor of the subject matter of the counts. The only "Question Presented" in this Court by him is this:

> "Should the District Court have decided the issue of patentability, in a suit under Sec. 4915, R. S., of the counts of the interference, first and foremost, even though the issue of priority be decided in this suit, against the plaintiff?"

Summary of Argument

I. Petitioner having acquiesced in the adverse decisions below on the issue of priority, a case or controversy under R. S. 4915 does not now exist.

II. Absent a case or controversy, the "Question Presented" is moot and not subject to review by this Court.

III. No conflict exists between decisions under R. S. 4915 on denial of relief to a plaintiff who concedes he is not the first inventor of the subject matter involved.

ARGUMENT

I

Petitioner Having Acquiesced in the Adverse Decisions Below on the Issue of Priority, a Case or Controversy under R.S. 4915 Does Not Now Exist.

R. S. Sec. 4915 (35 U. S. C. Sec. 63), so far as is here pertinent, is:

> "*Whenever* a patent on application is refused by the Board of Appeals or whenever *any applicant is dissatisfied with the decision of the board of interference examiners, the applicant,* unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, *may have remedy by bill in equity,* if filed within six months after such refusal or decision; *and the court having cognizance thereof,* on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled,* according to law, *to receive a patent for his invention,* as specified in his claim or for any part thereof, as the facts in the case may appear. *And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue*

> *such patent* on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. * * *" (Italics ours.)

The only case or controversy over which a court has jurisdiction under R. S. 4915 is one to determine whether the plaintiff is entitled to a patent. *Gandy* v. *Marble*, 122 U. S. 432, 30 L. Ed. 1223; *Hoover* v. *Coe*, 325 U. S. 79, 89 L. Ed. 1788. As stated in *Gandy* v. *Marble* (p. 440 of 122 U. S.):

> "All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

And a plaintiff who is not the first inventor, is not entitled to a patent. *Milburn* v. *Davis-Bournonville Co.*, 270 U. S. 390, 402, 70 L. Ed. 651, 654, states:

> "The fundamental rule we repeat is that the patentee must be the first inventor."

This Court will consider only the question presented by the petition. *Helvering* v. *Taylor*, 293 U. S. 507, 511, 79 L. Ed. 623, 627. *Helis* v. *Ward*, 308 U. S. 365, 370, 84 L. Ed. 327, 329. Wherefore, Petitioner, by failing to question the affirmance by the court below of the findings of the lower tribunals adverse to him on the issue of priority of invention, is bound as to that issue by the affirmance and must be taken as having conceded that he is not the first inventor of the subject matter involved. *Helvering* v. *Taylor*, 293 U. S. 507, 511, 79 L. Ed. 623, 627. *Helis* v. *Ward*, 308 U. S. 365, 370, 84 L. Ed. 327, 329. Since not the "first inventor", Petitioner is not entitled "to receive a

patent." *Milburn* v. *Davis-Bournonville*, 270 U. S. 390, 402, 70 L. Ed. 651, 654.

Disentitled to a patent by his own action, Petitioner has no standing under R. S. 4915. It avails him nothing. Neither the affirmance nor the reversal of the judgment below would make any difference as regards Petitioner's right under R. S. 4915 to a judgment authorizing the Commissioner to issue him a patent. Under such circumstances, this Court holds that a case or controversy does not exist. *Little* v. *Bowers*, 134 U. S. 547, 556, 33 L. Ed. 1016, 1020.

II

Absent a Case or Controversy, the "Question Presented" Is Moot and Not Subject to Review by This Court

The Constitution limits the exercise of the judicial power to "cases" and "controversies". *Aetna Life Ins. Co.* v. *Haworth*, 300 U. S. 227, 240, 81 L. Ed. 617, 620. Thus, a case or controversy under R. S. 4915 being absent, the "Question Presented" is abstract or moot and will not be considered by this Court. *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294; *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992; *United States* v. *Munsingwear*, 340 U. S. 36, 39, 95 L. Ed. 36, 41 and cases there cited.

It matters not when the event occurred which rendered it impossible for this Court to grant Petitioner (plaintiff) any effectual relief or, except as to costs, that the event occurred, as here, through an act of Petitioner, *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992.

The rule of this Court on questions which become moot pending appeal or review without fault of defendant is to dismiss the appeal. *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294; *Heitmuller* v. *Stokes*, 256 U. S. 359, 361,

65 L. Ed. 990, 992; *United States* v. *Munsingwear*, 340 U. S. 36, 39, 95 L. Ed. 36, 41. As said in *Mills* v. *Green*:—

> "The duty of this court, as of every other judicial tribunal, is to decide actual controversies by a judgment which can be carried into effect, and not to give opinions upon moot questions or abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it. It necessarily follows that when, pending an appeal from the judgment of a lower court, and without any fault of the defendant, an event occurs which renders it impossible for this court, if it should decide the case in favor of the plaintiff, to grant him any effectual relief whatever, the court will not proceed to a formal judgment, but will dismiss the appeal. And such a fact, when not appearing on the record, may be proved by extrinsic evidence. Lord v. Veazie, 8 How. 251, 12 L. Ed. 1067; California v. San Pablo & T. R. Co., 149 U. S. 308, 37 L. Ed. 747, 13 Sup. Ct. Rep. 876." See also United States v. Hamburg-Amerikanische Packetfahrt-Actien Gesselschaft, 239 U. S. 466, 476, 60 L. Ed. 387, 391, 36 Sup. Ct. Rep. 212, and cases cited.

III

No Conflict Exists Between Decisions under R.S. 4915 on Denial of Relief to a Plaintiff Who Concedes He Is Not the First Inventor of the Subject Matter Involved.

In alleging conflict between the decision below and decisions of courts of appeals of other circuits, Petitioner cites three cases:

Knutson v. *Gallsworthy* (C. A. D. C.), 164 F. 2d 497;
Minneapolis Honeywell Co. v. *Milwaukee Gas Co.* (C. C. A. 7), 174 F. 2d 203; and
Triplett v. *Line Material Co.* (C. C. A. 7), 133 F. 2d 533.

In all of the cited cases, priority of invention was continuously asserted by the plaintiff. In none did the court

hold that the issue of patentability should be determined when the plaintiff had conceded he was not the first inventor.

Petitioner has therefore cited no cases of conflict in the decisions of courts of appeals of different circuits on the "Question Presented" under the circumstances here existing.

No conflict in decisions having been shown, the ground upon which petitioner relies for granting the writ of certiorari completely vanishes.

Conclusion

As the "Question Presented" is moot and there is no conflict in the decisions under the circumstances here existing, the Petition should be denied.

Respectfully submitted,

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Of Counsel:

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF FOR RESPONDENT

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1952

No. 46

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF FOR RESPONDENT

Statement of the Case

In his complaint petitioner alleged (R. 1):

> "(4) The said Hugh W. Sanford, being *the original, first and sole inventor* [1] of improvements in Latch Tripping Mechanisms, duly filed in the United States Patent Office an application for Letters Patent of the United States on said invention, Serial No. 571,170, * * * ."

Therein he prayed (R. 5-6):

> "2. That the Court adjudge that the plaintiff, Hugh W. Sanford, was the *first, true and original inventor* of the said improvements in Latch Tripping Mechanisms, as set forth in his application, Serial No.

---

[1] Emphasis is counsel's unless otherwise noted.

571,170 and defined in the counts of Interference No. 82,623, * * *."

Three times the issue of priority has been decided against petitioner—once by the Board of Interference Examiners (R. 3, Par. 9), again by the District Court (R. 15), and still again by the Court of Appeals (R. 18). The District Court, hence, dismissed the complaint, finding it unnecessary to pass upon patentability. The Court of Appeals affirmed.

Those concurrent findings are here unchallenged. Though having here only the status of one who is *not* the first inventor and, hence, as one *not* entitled to a decree in his favor in an action under R.S. §4915 (35 U.S.C. § 63), petitioner nevertheless here presents this question:

> "Should the District Court have decided the issue of patentability, in a suit under Sec. 4915 R.S. on the counts of the Interference, first and foremost, even though the issue of priority be decided in this suit against the plaintiff?"

Thus petitioner whose right to a patent on the counts has been conclusively adjudicated against him, nonetheless here asks this Court to require the patentability of the counts to be determined.

Respondent, Kepner, opposed the granting of the petition for a writ of certiorari upon the ground that the question presented is moot and does not present a controversy under R.S. § 4915 or the Constitution of the United States.

Summary of Argument

Morgan v. *Daniels*, 153 U.S. 120 (1894), was an action under R.S. § 4915. It is decisive against petitioner of the single question here presented. The Court there laid down the now well-known rule as to the weight to be given in

actions under R.S. § 4915 to a decision of the Patent Office on the issue of priority. The Court found against the applicant upon the issue of priority. *Without passing upon patentability* the Court then said (p. 129):

> "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant; and *because of that fact*, and because of *the rule* that controls suits of this kind in the courts,
>
> "We reverse the judgment and remand the case, *with instructions to dismiss the bill.*"

In the case at bar the Courts below did just that.

Morgan v. *Daniels* was the last of a trilogy of cases founded upon R.S. § 4915—*Gandy* v. *Marble*, 122 U.S. 432 (1887), *Hill* v. *Wooster*, 132 U.S. 693 (1890) and *Morgan* v. *Daniels* (1894) that respectively hold:

1. "All the Court that takes cognizance of the bill in equity under § 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law to receive a patent; * * * .'" [*Gandy* v. *Marble*];

2. That if priority is found *in favor of the plaintiff-applicant*, patentability of the claims must be determined and the claims sustained before a judgment can be found for the plaintiff-applicant [*Hill* v. *Wooster*]; and

3. That if priority is found *against the plaintiff-applicant*, the complaint may be dismissed without passing upon patentability of the claims [*Morgan* v. *Daniels*].

Hill v. *Wooster* is without application to a case in which priority is found *against the plaintiff-applicant*, as *Morgan* v. *Daniels* is without application to a case in which priority is found *in favor of the plaintiff-applicant*.

The decisions here relied upon by petitioner as being in conflict with the decisions of the Courts below on the

question here presented, fail to construe *Hill* v. *Wooster* in the light of the facts with respect to which it was decided and reveal no awareness that that question was settled in the negative by *Morgan* v. *Daniels*.

Even if the usual "better practice" doctrine in patent infringement suits, as stated in *Sinclair & Carroll Co. Inc.* v. *Inter Chemical Corp.*, 325 U.S. 327, 330, were applicable to actions under R.S. § 4915, that doctrine is not mandatory and its nonuse by the Courts below was not error.

No actual controversy now exists between the parties with the consequence that petitioner is without right to demand that patentability of the claims be adjudicated and this Court is without jurisdiction under R.S. 4915 or the Constitution to hear his demand or order such adjudication.

Argument

I

MORGAN v. *DANIELS*, 153 U.S. 120 (1894) ESTABLISHES THAT THE COURTS BELOW DID NOT ERR IN FIRST RESOLVING THE ISSUE OF PRIORITY AND, HAVING FOUND PLAINTIFF-APPLICANT WAS NOT THE FIRST INVENTOR, IN DISMISSING THE COMPLAINT WITHOUT PASSING UPON PATENTABILITY OF THE COUNTS

A. The Holding of Morgan v. *Daniels*

Only the question specifically brought forward by the petitioner for the writ of certiorari is here to be considered. Rule 38, Par. 2; *General Pictures Co.* v. *Electric Co.*, 304 U.S. 177-179; *Helvering* v. *Taylor*, 293 U.S. 507, 511.

To that question *Morgan* v. *Daniels* answers that the Courts below did not err in holding that the trial Court may first determine priority and, if that is found against the plaintiff-applicant, the complaint may be dismissed without passing upon patentability.

R. S. § 4915 as it stood before the Court in *Morgan* v. *Daniels* is quoted in the report of that decision, 153 U.S. 120 at page 121, as follows:

> " 'Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled, according to law, to receive a patent for his invention,* as specified in his claim, or for any part thereof, *as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent* on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.' "

As far as here pertinent, the statutes here and there involved are identical, the present R.S. §4915 reading as follows:

> "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled, according to law,*

> *to receive a patent for his invention,* as specified in his claim or for any part thereof, *as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent* on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. * * *"

In *Morgan* v. *Daniels* priority was awarded in the Patent Office to Morgan. Thereupon, Daniels brought an action under R.S. §4915. In his complaint he alleged, as did Sanford in his complaint in the action at bar, "that he was the original, sole and first inventor of * * *" the subject matter of the claims in issue. The Circuit Court found Daniels to be the first inventor and without passing upon patentability of the claims involved, concluded:—

> "A decree will be made, authorizing the issue of the patent to the complainant as prayed." (*Daniels* v. *Morgan* (C.C. Mass.), 42 Fed. 451 (May 29, 1890).

Upon appeal by Morgan to this Court the evidence upon priority was reviewed, and the Court held (p. 125):—

> "Upon principle and authority, therefore, it must be laid down as *a rule* that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

Without a single reference to the patentability of the claims, this Court concluded with these words (p. 129):

> "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in

awarding priority of invention to the defendant; and *because of that fact*, and because of *the rule* that control suits of this kind in the courts,

"We reverse the judgment and remand the case, *with instructions to dismiss the bill.*"

This is precisely what the Courts below did in the case at bar.

Hill v. *Wooster*, 132 U. S. 693, was decided by this Court January 13, 1890, some four years before the decision in *Morgan* v. *Daniels*. The same statute was involved in each case. In each case the judgment of the Trial Court was in favor of the plaintiff-applicant. In each case the judgment of the Trial Court in favor of the plaintiff rested *solely* on the finding that the plaintiff was the prior inventor. *Hill* v. *Wooster* accepted the finding of the Trial Court favorable to the plaintiff-applicant on the question of priority and after quoting R.S. §4915, said (p. 698):—

"It necessarily follows that no adjudication can be made *in favor of the applicant*, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, *in favor of the applicant*, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved."

As stated above in *Hill* v. *Wooster*, the obligation to determine patentability, if the plaintiff is to prevail, is derived from the sanction given by the Court to the patent which it authorizes under the terms of the statute. *Hill* v. *Wooster* did not hold, nor did it intimate, that this rule should ap-

ply when the lower Court authorized no patent, and thus sanctioned nothing. It did not determine what obligation was upon the lower Court in the event the defendant prevailed on priority. *Hill* v. *Wooster*, therefore, imposes no obligation upon the lower Court to determine patentability in the event that the plaintiff does not prevail on priority. That there is no obligation under such circumstances was conclusively established four years later by *Morgan* v. *Daniels*, wherein this Court dismissed a bill under R.S. § 4915 on a finding adverse to the plaintiff solely on the issue of priority.

As stated in *St. clair* v. *United States*, 279 U. S. 749, 767, it is a fundamental principle that:

> "Always the language used in an opinion must be read in the light of the issues presented."

In *Safe Deposit & T. Co.* v. *Virginia*, 280 U. S. 83, 94 this Court after referring to some previous opinions stated the principle thus:—

> "Any general statement in the above opinions which may seem to interfere with the conclusion here announced must be limited and confined to the precise situation then under consideration."

Applying this principle, it becomes manifest that *Hill* v. *Wooster* is without application to a case in which priority is found *against the plaintiff*, as *Morgan* v. *Daniels* is without application to a case in which priority is found in *favor of the plaintiff*. Neither bars a decision on patentability in any case. However, neither *Hill* v. *Wooster* nor *Morgan* v. *Daniels* requires that patentability be decided "first and foremost",[2] or at all, if priority is not established by the plaintiff.

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[2] To require a trial court to determine any issue "first and foremost" would transgress its discretionary powers under Rule 42(b) of the Federal Rules of Civil Procedure.

B. The Decisions Below Followed Exactly the Pattern and Procedure Adopted by This Court in Morgan v. Daniels

The District Court in this case (R. 7):

> "took its position with the line of cases that holds that in a 4915 action patentability need not be considered where the claimed priority is not established, and, by the same token, when the one seeking the decree under 35 U.S.C. 63 prevails in the Trial Court upon the question of priority, the patentability of his claim must be decided."

In affirming the District Court, the Court of Appeals said (R. 20):—

> "But nothing in section 4915 or *Hill* v. *Wooster* can be taken as requiring the District Court to incorporate in a judgment dismissing applicant's claim of priority of invention an adjudication as to the defendant's entitlement to letters patent."

Then, after quoting from *Hoover Co.* v. *Coe*, 325 U. S. 79 (1945), the Court concluded (R. 21):

> "We think the foregoing language suggests at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority of invention."

Recognizing a privilege to decide patentability but construing *Hill* v. *Wooster* as having no application to an action in which priority is determined adversely to the plaintiff, the courts below dismissed the complaint without passing upon patentability. They followed exactly the pattern and result adopted by this Court in *Morgan* v. *Daniels* under identical circumstances. *Morgan* v. *Daniels* is therefore controlling and, it is submitted, requires affirmance of the Court below.

Since *Hill* v. *Wooster* and *Morgan* v. *Daniels*, there have been numerous decisions of courts of appeals involving the determination of patentability in interference actions under R. § 4915. The majority of these decisions, along with those of the Courts below, hold the mandate of *Hill* v. *Wooster* on patentability to be non-existent if the plaintiff is defeated on other grounds. Exemplary of such decisions are the following: *Smith* v. *Carter Carburetor* (C. C. A. 3), 130 F. 2d. 555; *Texas Co.* v. *McAfee* (C. C. A. 5), 299 Fed. 718; *Smith* v. *Prutton* (C. C. A. 6), 127 F. 2d. 79; *Cleveland Trust Co.* v. *Berry* (C. C. A. 6), 99 F. 2d. 517; *Heston* v. *Kahlke* (C. C. A. 6), 179 F. 2d. 222; *Philadelphia Storage Battery Co.* v. *Zenith Radio Corp.* (C. C. A. 7), 117 F. 2d. 642; *Boucher Inventions* v. *Sola Electric Co.* (C. A. D. C.) 131 F. 2d 225, cert. den. 318 U. S. 770; *Muther* v. *United Shoe Machinery Corp.* (D.C. N.J.), 7 F. 2d. 954.

Some cases, such as the three relied upon by Petitioner, *Knutson* v. *Gallsworthy*, (C. A. D. C.), 164 F. 2d. 497; *Triplett* v. *Line Material Co.*, (C. C. A. 7), 133 F. 2d. 533 and *Minneapolis Honeywell* v. *Milwaukee Gas Co.*, (C. C. A. 7), 174 F. 2d. 263, contain language which would indicate that a mandate for determining patentability is imposed upon the Trial Court, whether or not the plaintiff prevails on priority. As earlier pointed out, under *Hill* v. *Wooster* and *Morgan* v. *Daniels*, a Trial Court is privileged to determine either priority or patentability, or both, but has a mandate on patentability only in cases in which the plaintiff has prevailed on priority. On this basis, there is little inconsistency in the actual holdings of Courts of Appeals, and the statements in the three cases relied upon by Petitioner, which purport to extend the rule of *Hill* v. *Wooster* beyond its facts, are merely dicta.

Two of these three cases, *Knutson* and *Minneapolis*

Honeywell, were the same in their facts as *Hill* v. *Wooster* and the Court of Appeals in each case obtained the same result. Thus, in the *Knutson* case in which several actions involving related counts had been joined, the Trial Court found priority for a plaintiff as to one of the counts, making the determination of patentability mandatory, as held the Court of Appeals. In the *Minneapolis Honeywell* case the Trial Court adjudged the plaintiff entitled to a patent, requiring it, as it did, to determine both priority and patentability. The *Triplett* case is different in its facts from the other two. There the defendant raised the issue of patentability and the Trial Court dismissed the bill on a finding adverse to the plaintiff on this issue. It thus exercised its privilege to rest its decision on either ground, priority or patentability, which would defeat the plaintiff's suit. As opposed to their actual holdings, the inconsistent language of these cases requires no discussion since it shows a complete unawareness that this Court in *Morgan* v. *Daniels* had long since determined the inapplicability of the mandate of *Hill* v. *Wooster* to a case where the plaintiff had not prevailed on priority.

The fallacy in the dicta of the above cases is pointed out by Judge Simons in the *Heston* case wherein he said (Page 227 of 179 F. 2d.):

> "It has undoubtedly sometimes been thought, perhaps without too careful consideration of the precise language of Hill *v.* Wooster, supra, that it is the duty of the court in all circumstances to consider the question of validity, as in Palmer Pneumatic Tire Co. *v.* Lozier, 6 Cir., 90 F. 732, where it was declared that the power of the court should not be 'perverted to the determination of an unprofitable inquest as to who was the first discoverer of a nullity.' The seeming eloquence of this observation may, with equal logic, be met by the view that a court *should not be perverted*

by efforts to make a nullity of that which one has sought as a thing of value. As Judge Allen observed in the *Berry* case, Hill *v.* Wooster does not justify broadening of the issues under Section § 4915 at the instance of one who may not receive a patent so as to make it the 'practical equivalent of an infringement suit in which all the defenses known to the patent law may be brought forward.' (99 F. 2d: 522)."

C. There is No Basis in the Derivation of R.S. § 4915 or in Hoover v. Coe, 325 U.S. 79, for a Different Result Than Was Obtained in Morgan v. Daniels and the Courts Below

Petitioner in his brief endeavors to establish by reference to the Patent Acts of 1836 and 1870 a duty on the Trial Court to determine patentability in all interference actions under R.S. 4915 and a recognition of that duty by this Court in *Hoover Co.* v. *Coe*, 325 U.S. 79. Petitioner's contention, in short, is that Section 16 of the Patent Act of 1836 (Petitioner's App. 17) imposed on the Trial Court in an interference action the obligation to determine either priority or patentability and that the change in language with reference to interference actions in Section 52 of the Consolidated Patent Act of 1870 (Petitioner's App. 18) and a carry-over of the latter language to R.S. § 4915, showed the intent of Congress to make the determination of both issues mandatory. This interpretation Petitioner predicates on the terminology of the several Acts as to the basis on which judgment shall be rendered. In the Act of 1836 it is: "as the fact of priority of right or invention shall in any such case be made to appear". The corresponding provision in both the Act of 1870 and R.S. § 4915 reads: "as the facts in the case may appear". The change of "fact" in the earliest Act to "facts" in the later Acts,

petitioner asserts, shows the intent of Congress that the obligation shall be joint.

Petitioner, of course, presumes that the language of the later Acts means "facts of priority and invention" and he relies heavily on footnote 29 to *Hoover* v. *Coe*, 325 U.S. 79, 90, as so establishing. But this footnote has reference to the interfering patent portion of Section 16 of the Act of 1836 which is now covered by R.S. § 4918, 35 U.S.C. 66, and has no pertinency to R.S. § 4915.

As to the decision, itself, *Hoover* v. *Coe* was an *ex parte* action concerned with what Patent Office rulings were reviewable under R.S. § 4915. As pointed out by Mr. Justice Roberts in the body of his opinion, *Hill* v. *Wooster* "did not purport to decide" that issue and was therefore inapplicable. Nor did *Hoover* v. *Coe* purport to change *Hill* v. *Wooster*. Instead, as recognized in *Knutson* v. *Gallsworthy*, 164 F. 2d 497, 500, it "left the rule of Hill v. Wooster, supra, intact".

Further discussion of the vagaries of statutory interpretation into which petitioner would lead this Court is rendered wholly unnecessary by *Morgan* v. *Daniels*. That case was decided in 1894 and under a version of R.S. § 4915 which, in the language here pertinent, is identical with the present Act. By ordering dismissal of the bill solely on an adjudication adverse to the plaintiff on priority, without even considering patentability, this Court conclusively established that R.S. § 4915 imposes no duty on a Trial Court to determine patentability when the plaintiff has failed to established priority.

As to Congressional intent, it is a settled rule of statutory construction that where a statute or a portion thereof has been construed by a Court of last resort and the same is subsequently re-enacted, the Legislature must be considered to have adopted that construction. *Electric Bat-*

tery Co. v. *Shimadzu*, 307 U. S. 5, 14; *Sessions* v. *Romadka*, 145 U. S. 29, 41, 42; *Manhattan Prop.* v. *Irving Tr. Co.*, 291 U. S. 320, 336; *United States* v. *Elgin, J. & E. Ry.*, 298 U. S. 492, 500; *United States* v. *Ryan*, 284 U. S. 167.

Section 4915 of the Revised Statutes became law on June 22, 1874. It was amended on Feb. 9, 1893 by Sec. 9, c. 74, 27 Stat. 436; on March 2, 1927 by Sec. 11 of c. 273, 44 Stat. 1336; on March 2, 1929 by Sec. 2(b), c. 488, 45 Stat. 1476; and on August 5, 1939 by Sec. 4 of c. 451, 53 Stat. 1212.

Notwithstanding the several amendments, R.S. § 4915 has at all times contained the provision here pertinent that "the court having cognizance thereof * * * may adjudge that such applicant is entitled according to law to receive a patent for his invention, as specified in his claim or for any part thereof, *as the facts in the case may appear.* And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements".

Morgan v. *Daniels* having been decided by this Court in 1894, its construction of R. S. 4915 must be regarded as having been adopted by Congress not once, but three times.

II

PETITIONER HAS NO RIGHT TO A DETERMINATION EITHER OF THE QUESTION PRESENTED OR OF THE PATENTABILITY OF THE COUNTS.

Should this Court reverse the Court of Appeals as petitioner prays, it would make mandatory the determination of patentability in *all* interference proceedings under R. S. § 4915 and preclude the Trial Court from dismissing the complaint on a finding of priority adverse to the plaintiff. This, as has been shown, would conflict directly with *Morgan* v. *Daniels*, supra.

A reversal would also apply to actions under R.S. § 4915, a harsher rule than has sometimes been invoked in patent infringement suits under the so-called "better practice" doctrine. As that doctrine was stated by this Court in *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U. S. 327, 330, it is not mandatory but "usually the better practice" in infringement suits to determine the question of validity. In a patent infringement suit a sharp contest as to the validity of the claims can be expected. No such contest as to patentability ordinarily can be expected in a 4915 action in which both parties want the counts. Thus, even to apply the "better practice" doctrine to 4915 actions would unduly burden the Trial Court and to impose a mandate to decide patentability in all cases would be insufferable. As pointed out by Judge Leahy in a footnote to *Shell Development Co.* v. *Universal Products Co.*, (D. C. Del. 1945), 61 F. Supp. 925, 927, the Trial Court would then find itself in this dilemma:

> "In a 4915 proceeding both parties want the patent, neither would suggest questions of invalidity. The requirement that this Court must pass on validity removes this particular issue from without the adversary system. The Court, itself, must research through the prior art, be its own expert, become advocate for the government (but not for the Patent Office, which was of opinion validity existed) vis-a-vis both plaintiff and defendant. Perhaps the appointment of an advisory Master—for which there is no statutory authority—but on the basis of an exercise of the Chancellor's traditional powers—whose function will be to test validity at sword's length with both plaintiff and defendant, will meet the usual inability of the district judge to stop his business of judging to become an expert in many arts."

A reversal would do more. In the case at bar petitioner could have preserved the question of priority of invention

by including it in his petition to this Court. He deliberately chose not to do so. He thus stands finally adjudged not to be the first inventor of the counts. *Helvering* v. *Taylor,* 293 U. S. 507, 511; *Helis* v. *Ward,* 308 U. S. 365, 370. And a person who is not the first inventor is not entitled to a patent. *Milburn* v. *Davis-Bournonville Co.,* 270 U. S. 390, 402. So, petitioner having finally disclaimed prior inventorship, has no right to a patent on the counts.

To reverse the Court below, under these circumstances, and permit petitioner now to contest the patentability of the counts, would be a clear precedent for the loser, in an interference proceeding in the Patent Office, to convert a 4915 action into a trial of patentability of claims to which he makes no pretense of right. The advantage given to a claimant, intially bona fide, who finds at the Patent Office stage that he cannot establish priority is evident. Equally apparent is the opportunity afforded a fraudulent claimant to harass the holder of a recently issued patent.

But no such perversion of R.S. § 4915 was intended by this Court. Instead, it held in *Gandy* v. *Marble* that the only case or controversy determinable under R.S. § 4915 was whether the plaintiff-applicant was entitled to a patent. As there stated, (p. 440 of 122 U. S.):

> "All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

That R.S. § 4915 confers upon a court only limited statutory powers was again recognized in *Illingworth* v. *Atha,*

42 Fed. 141 (C. C. D. N. J., 1890) at 144 wherein Judge Green said:

> "This is purely a statutory proceeding, and the court cannot go outside the statute which is the foundation of the action to assume to itself powers not found in the purview of the act. The section under consideration has but a single object—to provide a way by which an unsuccessful applicant for letters patent, notwithstanding the rejection of his claim by the commissioner of patent, may obtain them through an adjudication, in favor of his right thereto, by a court of equity having cognizance of the subject matter; and, as the object of the section is single, so is the power of the court plainly limited under it to the accomplishment of that object. The prayer of a bill of complaint exhibited to the court under and by virtue of this section would be for a decree that the complainant has established his right to have letters patent issued to him. So far may the decree of the court go, but no further. It may adjudge an issue of the letters, or it may declare the complainant to be without right. In either case the power conferred by this section is exhausted."

Finally adjudicated not to be the first inventor of the subject matter of the counts and thus not entitled to a patent, petitioner now has no case or controversy under R. S. § 4915 as construed by *Gandy* v. *Marble*, supra. Yet, as set forth in his brief, petitioner here relies for jurisdiction solely upon that statute. Petitioner now having no standing under R.S. § 4915, it inevitably follows that his failure to preserve his claim of right to a patent deprived this Court of jurisdiction to determine the "question presented".

Whether a case or controversy was non-existent initially or became so pending appeal or review matters not. The result is the same. The Court is deprived of jurisdiction and the case must be dismissed. *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992; *United States* v. *Munsing-*

wear, 340 U. S. 36, 39, 95 L. Ed. 36, 41; *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294. And, except as to costs, it makes no difference that the event occurred, as here, by Petitioner's own act and without fault of the Respondent. *Heitmuller* v. *Stokes*, supra.

As said in *Mills* v. *Green*, supra:—

> "The duty of this court, as of every other judicial tribunal, is to decide actual controversies by a judgment which can be carried into effect, and not to give opinions upon moot questions or abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it. It necessarily follows that when, pending an appeal from the judgment of a lower court, and without any fault of the defendant, an event occurs which renders it impossible for this court, if it should decide the case in favor of the plaintiff, to grant him any effectual relief, whatever, the court will not proceed to a formal judgment, but will dismiss the appeal. And such a fact, when not appearing on the record, may be proved by extrinsic evidence: Lord v. Veazie, 8 How. 251, 12 L. Ed. 1067; California v. San Pablo & T. R. Co., 149 U. S. 308, 37 L. Ed. 747, 13 Sup. Ct. Rep. 876". See also United States v. Hamburg-Amerikanische Packet-fahrt-Actien Gesselschaft, 239 U. S. 466, 476, 60, L. Ed. 387, 391, 36 Sup. Ct. Rep. 212, and cases cited.

Even had *Gandy* v. *Marble* never been decided, petitioner would have no case or controversy cognizable by this Court under the circumstances here present. He has disclaimed any right to a patent on the counts and asserts no aggrievement from the holder of the Kepner Patent No. 2,487,447 in which those counts are contained as claims. He is therefore a complete stranger to the Kepner patent and has no more right than another such stranger to con-

test its validity. *Aralac, Inc.*, v. *Hat Corporation of America* (C. C. A. 3), 166 F. 2d. 286.

Conclusion

The Order granting the Petition for Writ of Certiorari should be vacated and the Writ denied; or, if Petitioner has a right to a review of the judgment below, it should be affirmed.

Respectfully submitted,

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